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108-462

SUPREME COURT OF THE UNITED STATES.

JOHN J. MANNING AND CALEB J. NORWOOD,
APPELLANTS,

v.

THE CAPE ANN ISINGLASS & GLUE COMPANY,
CHARLES W. PARKER AND JAMES B. ROWE,
DEFENDANTS.

BRIEF FOR COMPLAINANT AND APPELLANT.

THOS: WM: CLARKE.
of Counsel.

Supreme Court of the United States.

APPEAL FROM FIRST CIRCUIT, DISTRICT OF MASSACHUSETTS.

IN EQUITY.

No. 258.

JOHN J. MANNING AND CALEB J. NORWOOD,
Appellants,

v.

THE CAPE ANN ISINGLASS & GLUE COMPANY,
CHARLES W. PARKER AND JAMES B. ROWE,
Defendants.

BRIEF FOR COMPLAINANT AND APPELLANT.

HISTORICAL.

The bill was filed February 13, 1877.

The answer was filed May 7, 1877.

The replication was filed May 17, 1877.

The case was brought to hearing on the pleadings and proofs at the May term, 1879.

A decree dismissing the bill was entered November 11, 1879.

The appeal was filed in this Court September 6, 1880.

PLEADINGS, ISSUES AND DECISION.

Scope of the Bill.

The bill recites:

The grant of Letters Patent, January 7, 1873, to James Manning, assignor to C. J. Norwood, J. F. Manning and W. N. Manning, No. 134,690, for Improvement in the Manufacture of Isinglass; — the conveyance of said patent to the complainants, their exclusive right to the use and enjoyment thereof, and an Infringement by the defendants;

And prays Injunction and account.

Scope of the Answer.

The answer denies invention by the patentee, the value of the invention, and complainants' exclusive possession and exclusive rights under the patent; denies the use of the invention or intention to practise it, and infringement. Avers public use for more than two years before the application for patent; and abandonment and dedication by the patentee before the application. Sets up the knowledge of the invention by sundry people prior to the date of the patentee's invention; and avers that material parts of it were described in sundry Letters Patent; and avers that the improvement was not a patentable subject matter.

Undisputed Matters.

It was not controverted in the Court below that the parties to the suit were the proper parties.

Nor does the opinion of the Court below proceed upon the ground that the subject matter was not patentable, or that the complainants' assignor was not the first and true inventor of the thing described and claimed in the patent.

PUBLIC USE DECIDED TO HAVE BEEN PROVED.

The reason given for dismissing the bill was public use for more than two years prior to the application for the patent. And this was the only reason given by the Court.

ERRORS IN THE COURT BELOW.

The Court at Circuit found (Rec. 215, *316) —

1. That the invention had been in public use, *not for the purpose of experiment*, more than two years before the date of the application for a patent.

2. That this public use was of the same thing patented.

3. That whether the machine in use was of the precise form patented or not, the essence of the invention was not involved in the form of the machine.

COMPLAINANTS' CONTENTION.

Complainants contend as matter of law, and on the record as matter of fact:

CHEMICAL CHANGES OBVIATED BY THIS INVENTION.

1. That by a proper construction of the patent the invention therein patented is for an improvement in

the art of making isinglass, whereby, as testified (Prof. Babcock, Rec. 199, and following), an article better adapted for use in refining liquids, particularly beer, is produced, because the original *colloid* condition of the gelatine contained in the fish sounds, from which isinglass is made, is more perfectly preserved; which *colloid* condition is a *better* condition for the best work of refining and clarifying liquids *than* the *soluble* condition.

The colloid condition of the gelatine is liable to be disturbed by heating in the presence of moisture, and boiling destroys it entirely, and converts all the gelatine into soluble gelatine or glue, which is not suitable as a clarifier of cold liquids like beer, or wines, or cider.

COURT AT CIRCUIT CONCEDES THIS.

It is believed that on this point the Court below found in favor of the complainants, and that the contention cannot seriously be disputed.

His Honor Judge LOWELL describes the process very accurately (Rec. 213, *313) as far as he goes.

"Ribbon isinglass is made by passing the macerated bladders of fish, especially of hake, through several sets of rollers, which squeeze the substance first into a sheet somewhat like dough, and then into the translucent ribbons which are sold in the market. Heat makes the substance sticky and difficult to work in the earlier stages, and it is important that the first set of rollers, called mumming rolls, should be kept cool."

The evidence also shows that it is important that the other sets of rollers should be kept cool as well as the mumming rolls; and all of them, the mumming rolls, the sheeting or preparing rolls, the coarse ribbon rolls and fine ribbon rolls, have applied to them the apparatus patented to Rowe, spoken of in the opinion in these words: —

"Ebenezer Rowe, in 1848, patented a mode of keeping these rollers supplied on the inside with cold water, and this method has not been superseded."

THIS INVENTION IS DIRECTED TO MAKING SOUNDS INTO SHEETS.

2. The mechanical embodiment of the improvement made by the complainant was to be applied to all the rolls which are to form the sheets, — afterwards to be rolled into coarse ribbon, — which rolls are the *mumming rolls and* the *sheeeting or preparing rolls.*

All these rolls were to be scraped by *scrapers* which *prevent* the rolled *isinglass* from being *carried through* the rolls a *second time* without aeration.

It is stated in the patent (Rec. 29):

"Notwithstanding the constant application of cold water into the rolls, the substance adheres tenaciously to the roll and accumulates thereupon, and has to be cut away therefrom, an operation which is very slow and laborious, and productive of imperfect sheets."

"My invention is designed to obviate the return of the adhering gelatinous substance to the action of

the rolls before it is stripped therefrom, and to so strip it that the rolls may work continuously or without stoppage, the ribbon, as it is stopped, being again fed or guided by the operator into and between the rolls until sufficiently reduced or elongated for removal, or for the action of other rolls set nearer together to produce a thinner ribbon."

The result of this work, by preventing the return of the sheet to the compressing rolls, until it had been cooled and exposed to the air, was to prevent the formation of soluble gelatine to a very large degree, thus producing a different and better chemical constitution of the product.

Ascertainment of Dates.

It is important to ascertain the time when the automatic scraping of the *sheeting* rolls was introduced into the art.

Before any automatic scrapers were introduced, the mumming and sheeting rolls were scraped by a tool called a "spudger," a sort of a broad rude chisel used by hand, the two rolls being scraped alternately, or, if scraped at the same time by the spudger, by having two men, one to attend to each roll, and only partially clean it at each stroke of the spudger.

One mumming roll automatically scraped in 1860.

The first thing that was done by Manning was to arrange a scraper on one of the mumming rolls (Rec. 18, cross-int. 34).

This scraper was a piece of iron attached to the

bed of the opposite roll from the side on which the operator stood at the frame at work (Rec. 17, cross-int. 28).

And the roll to which the scraper was attached was all boarded up underneath so that you could only work on one side (Rec. 24, int. 9, *Norwood;* Rec. 156, cross-int. 7, *Smith*). "Mr. Norwood showed me an arrangement of the pan on the under side by which the stock from the roller was carried all on one side, so that one man could tend the machine."

This scraping a Labor-saving Expedient only.

It thus appears that the first arrangement was merely a mechanical arrangement to allow one man to take charge of the mumming rolls instead of having two.

How long this thing continued in this form with but a single scraper, is one of the questions of fact in the case.

No Improvement made till 1868.

John J. Manning said, in cross-examination, that the scraper was first *changed to the boxes* of one roll, then they were made sharp, and then changed to an angle of forty-five degrees, about; and that they went on for six years, until the firm of Norwood & Manning was dissolved, in 1867, when Caleb Norwood took the set of rolls which was provided with the scraper.

Rec. 18, cross-int. 38; Rec. 19, cross-int. 48.

SHEETING ROLLS FIRST SCRAPED BY MANNING IN 1868.

In the early part of the spring of 1868 *two* sets of rolls were made with scrapers, and two scrapers were made to each set, for James Manning, and these were set up for use in his new factory for the season of 1868–9, and one scraper of each set was attached to the stationary box, and one scraper of each set was attached to the bed of the rolls.

FIRST FORM BAD. PRESENT FORM ADOPTED 1871.

In 1871 the scrapers of the adjustable roll had their attachments changed from the bed to the boxes of the roll, and they were used in that way in James Manning's factory at Rockport from 1871 till now, the sons of James Manning running the factory and carrying on the business, the father working for the sons.

During the summer the factory was closed, the scrapers taken off, and the rolls covered up so that they cannot be seen.

Twelve or thirteen workmen were employed in James Manning's factory by John J. and William N. Manning, sons of the owner and inventor.

None of these workmen have testified, and no information has come from that factory.

NO SHEETING ROLLS SCRAPED ANYWHERE ELSE BEFORE 1873.

In 1868 the firm of C. Norwood & Son was formed to go into the isinglass business, taking the old mumming rolls of Norwood & Manning (Rec. 23, ints. 3–6).

These old mumming rolls had at that time the two knives.

The only controversy about this date, 1868, as the date of the beginning of the use of two scrapers upon the mumming rolls, is in the testimony of Smith, the machinist, who testifies, entirely from recollection, of making a set of ten-inch rolls in 1860 (Rec. 103, int. 10), to which, after they were set up, scrapers were added (Rec. 104, int. 13); one of which he remembers was bolted stationary, as Manning said (Rec. 110, cross-int. 91).

But Mr. Smith made some mistakes in his testimony, and was recalled (Rec. 155); and it appears that he remembers the breaking of the slides of the guide for the movable boxes of the rolls, just as John J. Manning said (Rec. 156, cross-int. 7); and is not certain about the forward scraper on the old mumming rolls.

From this evidence the Court could only infer that the application of the scrapers to each mumming roll was not made till 1868; and that the application of the scrapers to the second set of rolls was only made in the factory of James Manning himself in that year.

In the Norwood factory the evidence is clear that until 1873, when the machinery was changed (Rec. 23, int. 5), they had only the mumming rolls provided with scrapers, and that the *sheeting rolls* were *not provided with scrapers.* Also that the mumming rolls were set at quarter inch gauge, and could not

be used for sheeting (Rec. 26, cross-ints. 35–37; 156, cross-int. 7).

The patent describes (Rec. 29) that the material comes from the rolls in continuous sheet form.

The claim is for converting isinglass into *sheets* of any desired thickness, which sheets are removed from the rolls by stationary scrapers or clearers.

Since 1873 C. Norwood & Son have had two sets of rolls provided with scrapers, just as James Manning had from 1868; all the isinglass going through both sets. But *until* 1873 the *sheets* were *not made on the rolls* that were *provided with scrapers* (Rec. 27, cross-ints. 39–42; Rec. 24, int. 13, "Exhibit C").

The increase in the quantity by the use of scrapers in this way was from 300 weight to 1200 weight (Rec. 27, cross-int. 44, and int. 49).

No pretense is made that anybody, except the workmen and the sons of James Manning, went into James Manning's factory at Rockport from 1868 to 1872.

The evidence applies wholly to the factory of Norwood & Manning, in which only one roll was scraped before 1867, and the factory of C. Norwood & Son, in which only the mumming rolls were scraped. This carried the process along but a short distance and did not produce sheets.

Defendants' Answer denies Sheeting.

On turning to the answer this will be found material, for the issue is distinctly set up (Rec. 6, ans. to int. 6). Defendants have had "two machines

containing hollow metal rolls cooled by water and provided with metal scrapers, which were so fixed and adjusted with relation to the cylindrical surfaces of the rollers as to prevent the accumulation thereon of the masticated fish sounds; but that such machines *were not used* for converting isinglass into *sheets*, nor did the *scrapers* contained therein *remove* the masticated fish sounds adhering to the rollers in any other form than that of *discontinuous irregular masses*."

COMPLAINANTS PROVED SHEETING ON THE ROLLS.

This statement of the answer is directly contradicted by Wendell, Grimes & Shaw.

Shaw worked at the mumming rolls, which were like "Exhibit A" (Rec. 10, int. 3), sometimes making the mummings into sheets, and sometimes not carrying them along so far (Rec. 11, int. 9).

Wendell worked at the preparing rolls to which Shaw delivered the mummings (Rec. 10, ints. 8, 9; Rec. 9, int. 2); and the preparing rolls are like "Exhibit A" (Rec. 10, cross-ints. 5, 6), with scrapers; and they came out from the preparing rolls in sheets (Rec. 9, int. 8; Rec. 10, int. 5), and were transferred to Grimes who worked on the coarse ribbon rolls (Rec. 9, int. 2), which did not have scrapers (int. 3).

NORWOOD'S PROCESS BEFORE 1873 NOT THAT OF THE PATENT, WHILE THE DEFENDANTS' IS.

The process, therefore, practised at Norwood's factory up to 1873 did not go to the extent of the

sheeting described in the patent, while the process practised at defendants' does go to the extent of the sheeting described in the patent.

The Court at Circuit perhaps assumed this to be a question of degree, and decided that the use from 1868 to 1871, two seasons and a half, was a public use in that factory.

But one witness is called who was not a workman in the factory, Spiller, a deputy sheriff, who went occasionally, at some time, to serve trustee processes (Rec. 111). This was before the year 1870. He said that he went in when the machinery was going so that he would have to speak pretty loud. He does not describe the machinery, or say that he saw it, but simply that he heard it.

Some of the workmen say that other people occasionally came into the factory.

Hillard remembers that in 1861, 1862 and 1863 there was *a knife* on the big rolls (Rec. 174, ints. 9, 10).

Very few strangers ever came to the factory (Rec. 176, int. 34). One man was up there to buy a cow, and he thought he would come in (int. 37). And one was Mr. Norwood's brother-in-law; and one was Ebenezer Rowe, an isinglass manufacturer, who tried to come in and was not permitted, only coming into the first door (Rec. 177, cross-int. 44). And another was a man named Randall, who, on recollection, was sent outside and was not allowed to come into the second door (Rec. 177, cross-int. 54). A neighbor, Mr.

Warner, who owned part of the mill, came in. And this man Hillard once showed the isinglass factory to some young ladies (Rec. 177, cross-int. 64).

Esrom Morse, a witness for the defendants, testified that there was "No Admission" on the outer door leading to the factory (Rec. 100, cross-int. 66). That it was not the custom to admit people (cross-int. 32); and that he did not feel at liberty to give information about the affairs of the factory (Rec. 98, cross-int. 40).

And it appears that there were two doors to the factory, an outer door and an inner door. The stove was near the door, about four feet from the inner door. The mumming rolls were farthest away from the door (Rec. 99, cross-ints. 47, 48).

C. B. Morse remembers that occasionally, and only in the years before 1867, Mr. Warner and Mr. Smith, two neighbors, occasionally came into the factory and walked around (Rec. 102, cross-ints. 15–19).

And Esrom Morse saw some farmers, who came to the grist-mill, in there (Rec. 97, cross-int. 28).

Stevens has an impression that "No Admittance" was on the outer door of the factory (Rec. 94, cross-int. 42). And that during the life of C. Norwood, a Mr. Warner was refused admittance (Rec. 94, cross-int. 44). And that during later years it was not customary to admit people into the factory (cross-int. 95).

Farr testified to nothing before 1868; and Dennis to nothing before 1868. Robins to nothing prior to the date of the patent.

This is the evidence claimed to prove use in public, and the whole evidence claimed to prove use in public.

To sum up, the Court asserts in substance this:

That a factory at Ipswich, run by water power, situated on a river adjacent to a grist-mill that used part of the water power, — belonging in part to Caleb Norwood, and in part to one Warner, — having only two neighbors, Warner and Smith, — Warner owning the factory, — where a few people came in occasionally, no one of whom saw the machinery, but who were farmers and young ladies, — where people who happened to be in the neighborhood, sometimes came into the rooms where some of the rolls were in operation, and sometimes only into the outer room between the two doors, where they sat by the stove and smoked, but of all of whom not one person, except the workmen, identified or is called to say that he saw this machinery, or any machinery, at work at the process, — was so public a place that use of a *single set of rolls, partly carrying on the process* therein, was a public use of the whole process which made the invention public property.

PUBLIC USE A FACT.

Pennock v. *Dialogue*, 2 Pet. 1.

WORKMEN AND SERVANTS AND PUBLIC OFFICERS ARE NOT THE PUBLIC.

This differs entirely from the cases in which a public use has been declared as matter of fact.

"The trade or manufacture does not lose its character, by being confidentially disclosed to agents or servants without whose assistance it cannot be made of value."

Peabody v. *Norfolk*, 98 Mass. 452, 461, and cases cited.

The presence of the deputy sheriff in pursuance of his duty to serve processes was not the presence of the public.

"Even if, as is argued in support of the demurrer, the process is liable to be *inspected by* the assessor of internal revenue or other *public officer*, the *owner* is not less *entitled to protection* against those who, in or with knowledge of, or in violation of contract and breach of confidence, undertake to disclose it and to reap the benefit of it."

Peabody v. *Norfolk*, *ubi supra*.

A workman, at least an American, is under an implied contract to keep his employer's secrets and not give away his employer's business.

Keene v. *Wheatley*, 9 Am. L. Reg. 33.

The facts in evidence in the case appealed fall very short of those in the cases below cited in the opinion.

One of the cases on public use is *Tappan* v. *The National Bank Note Company*, 2 Fisher, 195, in which it was attempted, on a patent only two months old, to obtain a preliminary injunction, by proof that

the public had acquiesced in the exclusive title of the patentee to the invention. This proof was made by proving that the patentee had permitted the complainants to use one or more of the patented machines for more than two years before his application for a patent. And Judge SHIPMAN very properly held that to make this use an acquiesence of the public it must have been a public use, and that would make the patent void. But he rested the decision of the case upon the proposition that the use must have been a private use until the date of the application for the patent, and that therefore the patent would be good; and as it was only two months old there had not been a public acquiesence in its validity, sufficient to authorize the grant of an injunction.

Another case is *Biven* v. *Easthampton Bell Co.*, 9 Blatchford, 50.

The patentee had built and used several furnaces for a long period of time before taking his patent, and several of his neighbors and rival manufacturers had built and used to his knowledge in the same town, openly and without question, several furnaces apiece, according to the pattern that he had contrived. The invention was made in 1852, and the patentee then applied for a patent, which was rejected, and the papers taken off file. The defendant's furnace was built in 1853. A patentee renewed his application as late as 1862. He took his papers again off file in 1863, and made a new application in 1869. On this the patent was granted upon which he sued.

So he was suing to obtain an injunction against a machine that had been in existence to his full knowledge sixteen years before the date of his patent.

In the appealed case the defendant's machines were made and set up after the date of the patent, were worked exactly according to the methods of work of the patent, which no rival manufacturer heard of until after the date of the patent.

Pitts v. *Hall*, 2 Blatchf. 229, was a case at law where the plaintiff recovered.

The proof was, the machine was completed in June, 1843, used in the year 1843, was altered in the spring of 1844 by changing some proportions, and the patent was applied for in April, 1846. In this case Mr. Justice NELSON said: —

"This ground of forfeiture [from public use or use in public] is not favored in law. . . . The evidence therefore should be quite clear that the use was not by way of experiment or for the purpose of perfecting the machine, in order to justify the conclusion that the patentee had forfeited his right to the improvement."

Heath v. *Smith*, 3; *Ellis* v. *Blackburn*, 256.

The proof was that five different firms had conducted the process in England, three of them without concealment, before the date of the plaintiff's patent; and the Court found that under the English statute for the granting of patents for "new manufactures which others at the time of the making of such Letters Patent and grants shall not use," this was not a

"new manufacture" at the date of the patent. It was held by two judges of the King's Bench that the invention was not novel.

In *McClurg* v. *Kingsland*, 1 How. 202, the suit was brought by a patentee against his employer, under whose direction and at whose expense he had made the experiments which resulted in the invention, having his wages increased on account of his success. After success had been reached, he worked the process openly in the employer's factory. It was held that this was such a condition of things that, at any rate, did not allow the workman to bring suit against the employer. But it was not held to have been a public use so as to avoid the patent.

In *Sisson* v. *Gilbert*, 9 Blatchf. 185, the evidence was that the patentee had made and sold, between 1845 and 1853, twelve machines, all having some, and some having all, of his patented improvements; and that during eight or ten years before the patent was applied for, at least two other manufacturers were making and selling similar machines with these improvements, to his knowledge. He applied for a patent in 1859.

In the *Adamson's patent* case, 6 DeGex, McNaughton & Gordon, 420:

The machine which it was desired to patent had been used in a public harbor, working on a public pier, at a public watering-place, in the presence of thousands of people daily for four months. That was held to be a public use.

In *Egbert* v. *Lippmann*, 14 Off. Gaz. 822, which is one of the cases most relied on in the opinion, the facts as stated in the opinion are much beyond the facts in the appealed case. The plaintiff proved that he made the invention in 1855, and gave a pair of steels embodying it to a lady, who wore them; and made her another pair in 1858. He made another pair in 1863, for another lady. Plaintiff married one of his donees in 1863; and in 1863, after her marriage, the corsets were taken off, ripped up, and shown to one Sturgis, and the patentee explained to him how the steels were made.

This clearly was not a secret use by an employee. The showing of the steels in use, in 1863, to Sturgis, and the explanation of them to him, was certainly a public use. The giving of the steels, not in corsets, to two ladies for use by them, was certainly a communication of the invention to the public.

The case differs from the present in the fact that there was a positive disclosure of the invention to three different persons who were not employees, and who apparently were not under any rules binding them to secrecy, more than two years before the application for a patent; while in this case the only persons who know anything about the machines or process, are persons who were in confidential relations with the patentee, or his immediate relations.

In *McMillan* v. *Barclay*, 5 Fisher, 189, the patentee bought the steamer "Silver Wave" in 1854. He fitted her in 1855 with the patented machinery. He used that

patented machinery on the boat from that time on; and he himself navigated the boat for many years. The invention was a method of working the capstan, which was on the open forward deck, by the nigger engine, also on the open deck, by shafts and bevelled gears which connected the engine to the capstan, which shafts and bevelled gears were mostly in full sight above deck.

The patent was applied for April 25, 1865.

Of course every freighter had an opportunity to see the connection between the engine and the capstan, and that being so, it was undoubtedly public use.

In *Shaw* v. *Cooper*, 7 Peters, 292, the invention was made in 1813 or 1814, in England. Several guns embodying the invention were used in England before 1819, and they were in general use there in 1820 and 1821; and were known and used in France in 1821; and generally known and used in the United States from and after June 19, 1822, on which date the original patent (of which the patent in suit was a reissue) was taken out. The plaintiff had disclosed his invention in England to his brother, to a gunsmith, and to others, and also to a gun-maker in Philadelphia, long before the date of his first patent. Undoubtedly under the law, as it then stood, this was a public use before June 19, 1822, in England.

In *Elizabeth* v. *Pavement Co.*, 97 U.S. p. 126, the patentee set the pavement in a public street in Boston six years before he applied for a patent on it;

and it was held that this use was essential to test the invention, and did not forfeit the right to obtain a patent.

So in *Draper* v. *Wattles*, C.D. 1877, 566, the patentee had nearly the same thing in use, but did not forfeit.

In *Campbell* v. *The Mayor*, &c., C.D. 1881, 479, Knibbs, the patentee, put the thing patented in use on a Troy engine in April, 1860, and in January, 1862, duplicated it on another engine; and in 1861, the invention was adopted by the Amoskeag Co. and put on engines made by them. This was held not to be a public use to forfeit the inventor's rights.

In *Kells* v. *McKenzie*, 10 Fed. Rep. 285:

The machine was sent out for trial to a distance, more than two years before the application, with an optional price given at which it could be kept. It was returned because of defects not in the patented parts. Judge BROWN held this was a putting on sale.

But in the appealed case no machine was put out, and the process was worked only in the inventor's own factory.

In *Edgarton* v. *Furst & Bradley Mfg. Co.*, 9 Fed. Rep. 450:

The patent was held void because rakes fully embodying the invention, made and sold more than two

years before application to neighbors, and used in the fields, were actually produced at the hearing.

SUMMARY.

1. Use in public or public use has not been shown more than two years before the application for patent.

2. The process is one the effect of which could not have been anticipated as improving the quality of isinglass.

3. It was not begun to be practised in its entirety till the fall of 1868 in James Manning's own factory.

It was not practised in its entirety until 1873 at Norwood's.

The machines now used for practising the invention by the patentees did not exist in their present state until 1871.

4. Construing the patent to require the process with scrapers to be carried on to the complete production of sheets, the defendants have practised it fully and completely, although they deny it in the answer.

5. And construing the patent to require the use of the complete machine, as described, the defendants employ the precise machine.

6. Under these circumstances, whatever be the construction of the patent, public use has not been shown, and infringement has been.

7. The single rolls scraped with one scraper, used for the making of glue from boiled size, or the rolls

provided with scrapers not having water thrown into the inside of them, used for crushing sugar, or the rolls without the water injection, running at different speeds, provided with a single scraper, used for the manufacture of printers' ink, were clearly not anticipations.

8. The long, hinged spudger used at the Gott & Giles factory for one season, clearly did not scrape, simultaneously and continuously, both rolls as required by the patent, but it was a failure. It was put up garret, and never used but one season.

Unanticipated by documentary evidence, or evidence in the country, with a clear imitation of the method and means of the complainant exactly as the complainant's patent describes it, and to the extent to which it describes it, and with proof that the complete process could not have been practised before 1868, nor have been used in public before 1873, the complainants ask that the decree dismissing their bill may be reversed, and that a mandate may go directing a decree for injunction and account.

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OFFICE SUPREME COURT U. S.
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Supreme Court of the United States.

MANNING *v.* CAPE ANN ISINGLASS CO.

ADDENDUM TO COMPLAINANT'S BRIEF.

The following additional cases, bearing upon the evidence which supports the doctrine that there was no public use of these machines, are cited:

In *Egbert* v. *Lippman*, before the Supreme Court (21 Off. Gaz. p. 75, 104 U.S. 333), the decision of the court at circuit already cited was upheld, and the proposition is made: "If an inventor, having made his device, gives or sells it to another, to be used by the donee or vendee without limitation or restriction, or injunction of secrecy, and it is so used, such use is public within the meaning of the statute, even though the use and knowledge of the use may be confined to one person—"

In the present case, the invention being for a process which consisted in carrying forward the rolling of sounds on cooled rolls, and stripping the sounds from the rolls after one passage, and carrying this rolling and stripping process forward until the sounds are made into sheets, not stopping it at the mumming where it is only a mechanical convenience, but carry-

ing it forward to the sheeting rolls to produce an improved chemical result, the practice of the process was confined entirely to the factory of the patentee, and it was not given away or let to use by any person.

In *Worley* v. *The Loker Tobacco Company* (21 Off. Gaz. 559, 104 U.S. 340) the evidence went much further than in the present case, for, before the patent was applied for, at least one rival manufacturer learned the process, and adopted it in his own factory from observing it in the factory where it was carried on for McCabe by Worley.

In the present case, it appears that the only rival manufacturer who ever attempted to enter the Norwood factory was excluded, and that the process was not adopted by the defendant, or by anybody else, until after the issue of complainant's patent, and, indeed, after an attempt to inspect complainant's machine, at a time subsequent to the issue of complainant's patent. The process was kept secret.

So also in *Vinton* v. *Hamilton* (31 Off. Gaz. 557, 104 U.S. 485) there was distinct proof of the public use of all the parts and features of the process, and of the mechanical details thereof, more than two years before the complainant's patent, by several other persons.

In *Graham* v. *McCormick* (21 Off. Gaz. 1533) the statutory two years began to run on December 2, 1863; and it appeared that in the year 1863, a machine embodying the invention was built and deliv-

ered on trial, and was warranted by the patentee. This machine proved unsuccessful. Judge DYER (p. 1533) very justly says: "This part of the defence rests upon a claim of forfeiture of rights secured by the patent. To justify the court in sustaining it, the proof should be clear and satisfactory. The right of the infringer to invalidate the patent for this cause should be undoubted. And in view of these considerations we think the patent should be held valid against this objection."

In *Graham* v. *The Geneva Lake Crawford Manufacturing Company* (21 Off. Gaz. 1536), on the same patent the same date was given to the statutory two years, namely, December 2, 1863, and the same rule was held. And the contrasted opinions of Judge SHEPLEY and Judge LOWELL in *Henry* v. *Francestown Soapstone Stove Company* (9 Off. Gaz. 409, and 17 Off. Gaz. 569), are referred to, and that of Judge SHEPLEY was accepted.

"The fact of a public use or sale more than two years prior to the application, when clearly proved, is fatal to the patent. But the objection rests upon the principles of forfeiture, and it is not to be so favorably regarded as to dispense with the necessity of strict proof. Public use in good faith for experimental purposes, while the inventor is perfecting his invention, and for a reasonable period even before the beginning of the two years of limitation, cannot affect the rights of the inventor."

The stoves were delivered on trial, to be returned

if the invention did not work satisfactorily; and in such cases Judge SHEPLEY held that they "are to be regarded rather in the light of practical tests, such as the law permits the inventor to make, than as such public sales as tend to show abandonment, or mislead the public into a belief that the inventor had made a dedication to the public."

Judge LOWELL's views in the same case on rehearing are as follows (17 Off. Gaz. 569): —

"In my opinion, the evidence tends to show a sale of the invention. True, some sales were conditional, that is to say, the stoves were to be returned if they were not satisfactory to the buyers; but this does not, without further explanation, prove that they were experimental. It may show that the purchaser had doubts about the article, but does not prove any on the part of the seller. Sales in the usual course of business, whether absolute or conditional, if they are sales of the patented thing, work a forfeiture. A single sale has this effect as well as a hundred sales. It is very unlikely that a buyer would take what he understood to be an experimental thing; but, if he did, the evidence should be unequivocal that a test of the invention was one of the purposes of the seller. This article could be tested by the inventor as well in his own house as in any other place; and when he sold it in its completed form, though with warranty or on condition, he sold it."

And Judge LOWELL further holds (p. 570), that the sales made of the stoves referred to constituted

the fact provided for in the statute, namely, the being "on sale."

In *Hall* v. *Macneal*, 2d S.C. Reporter, 73, it was held that the tapering arbors secured by keys for fastening two or more plates of metal together in safes patented to Hall, July 23, 1867, were fully shown in a patent to the same inventor for a lock, September 25, 1860; that the distinction attempted to be drawn between the precise thing of the patent, a solid screwed conical bolt, and similar things existing before, a hollow screwed conical bolt, and a solid smooth conical bolt, involved no invention; and that the use of solid smooth conical bolts in two safes made by the plaintiff and sold in 1859 and 1860, was a putting in practise of the invention, and that the exhibition of these safes at county fairs and sale of them, and the subsequent use by the vendees in 1859 and 1860, and later, constituted the "two years public use and on sale of the statute."

The language of the statute (Rev. Stat. § 4886), is that —

"Any person who has invented or discovered any new and useful article, machine, manufacture or composition of matter, or any new and useful improvement thereof, *not known or used by others in this country*, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, and *not in public use or on sale* for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by

law, and other due proceedings had, obtain a patent therefor."

And the defences allowed in a patent suit are, among others, that it had been *in public use or on sale* in this country *for more than two years* before his application for a patent.

It is suggested that the words "on sale" do not mean that a single article or two or three articles shall be sold, but that it should be an article exposed for sale to all comers in the ordinary and unconditional way; and that public use is not use simply in one place or in one factory, or two places or two factories, but that in addition to use there must be publicity of use. The publicity of use is a point to be proved affirmatively by the defendants, as well as the mere use.

And in proof of publicity of use, a workman servant is in a domestic and not a public relation as observer.

No one but workmen and a deputy sheriff have testified.

A public officer, serving process only, is not the eyes of the public to acquire property for them.

108-462

SUPREME COURT U.S.
APR 3 1883
J. H. McKENNEY

Supreme Court of the United States.

108-462

No. 258.

JOHN J. MANNING and CALEB J. NORWOOD,

APPELLANTS,

v.

THE CAPE ANN ISINGLASS AND GLUE COMPANY, CHARLES W. PARKER and JAMES B. ROWE,

APPELLEES.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES FOR THE DISTRICT OF MASSACHUSETTS.

BRIEF ON BEHALF OF THE APPELLEES.

GEORGE L. ROBERTS,
Of Counsel for Appellees.

BOSTON:
ALFRED MUDGE & SON, PRINTERS, 34 SCHOOL STREET.
1883.

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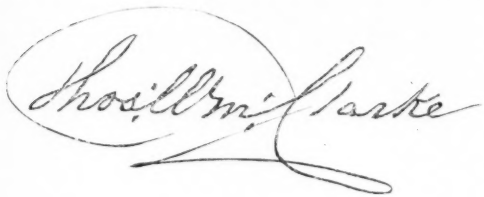

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BRIEF FOR APPELLEES.

Abstract of the Case.

This is a suit in equity brought in the court below against the present appellees as defendants, for alleged infringement upon letters patent No. 134,690, dated January 7, 1873, and granted to John J. Manning, Caleb J. Norwood (the present appellants) and William N. Manning as the assignees of James Manning, for his alleged invention therein entitled, "Improvement in the manufacture of isinglass."

Bill of Complaint, pp. 1–4 [*Transcript Record*, pp. 1–3].

The subject matter of the patent sued upon is thus set forth in the single claim thereof: —

"I claim —

The herein-described method of converting isinglass into sheets of any desired thickness by running it between hollow rolls into which cold water is thrown to cool the compressing surfaces, such rolls being preferably made adjustable to graduate the degree of compression, and the adhering sheets being removed from the rolls by stationary scrapers or clearers and returned to the hopper as required."

Letters Patent No. 134,690, pp. 41–43 [*Tr. Rec.* pp. 28–30].

The defences set up and relied upon are,

First, that the said alleged invention had been in public use for more than two years before the said James Manning's application for a patent therefor.

Second, that the said James Manning was not the original and first inventor of the thing set forth and claimed in the said patent; but that the same had been, before his assumed or pretended origination thereof, known and used

by others and described in certain letters patent as particularly specified in the answer.

Third, that the thing set forth and claimed as new in the said patent was not the subject matter of invention nor a patentable novelty.

Defendants' Answer, pp. 5–8 [*Tr. Rec.* pp. 4–7].

I. *Defence of public use more than two years before application.*

The court below decided the case in favor of the defendants upon the first of these issues, and did not have occasion to consider the remaining defences.

Opinion of the Court, pp. 213–215 [*Tr. Rec.*].

The state of facts upon which this decision was based is briefly as follows: —

James Manning, for whose alleged invention the letters patent in suit were granted, was in the year 1860 and theretofore engaged in the business of manufacturing isinglass, as copartner with one Caleb Norwood, his brother-in-law, at Ipswich, Mass., under the firm name of Norwood & Manning.

John J. Manning, Cross-Int. 40, p. 26 [*Tr. Rec.* p. 18]; Cross-Int. 67, p. 29 [*Tr. Rec.* p. 20].
Caleb J. Norwood, Int. 2, p. 33 [*Tr. Rec.* p. 23].

In 1859 or 1860 there was constructed for the said firm of Norwood & Manning, and put into use by them, a machine containing adjustable hollow water-cooled rolls and stationary scrapers, such as is described in the said patent and referred to in the claim thereof, for converting isinglass into sheets according to the method therein set forth.

Oliver C. Smith, Ints. 4–14, pp. 150, 151 [*Tr. Rec.* pp. 103, 104]; Ints. 24–28, p. 153 [*Tr. Rec.* p. 108]; Cross-Ints. 89–91, p. 160 [*Tr. Rec.* p. 109, 110]; Cross-Ints. 97–99, p. 161 [*Tr. Rec.* p. 110].

This machine was thereafter continued in use by the said firm of Norwood & Manning down to 1867, when the partnership was dissolved, and in the division of assets which ensued the same machine became the property of the said Caleb Norwood.

John J. Manning, Cross-Ints. 27–39, pp. 24–26 [*Tr. Rec.* pp. 17, 18]; Cross-Ints. 42–48, pp. 26, 27 [*Tr. Rec.* pp. 18, 19].

Caleb Norwood then took his son Caleb J. Norwood into business with him, and the firm thus constituted under the name of C. Norwood & Son continued the use of the same machine in the manufacture of isinglass from 1867 to 1870, when the father died; and thereafter the son continued the business under the same name and used the same machinery down to 1873, the year of the issue of the patent here in suit.

Caleb J. Norwood, Ints. 3–5, p. 33 [*Tr. Rec.* p. 23].

Meanwhile, James Manning, immediately after the dissolution of the firm of Norwood & Manning, established a factory for the manufacture of isinglass at Rockport, Mass., and caused to be constructed and set up therein, among other things, two similar machines having hollow rolls for the introduction of cold water and provided with stationary scrapers just as described in the patent in suit. With this factory and machinery he set up in business his two sons, John J. Manning and William N. Manning, and they carried on the manufacture of isinglass under the firm name of J. J. Manning & Brother, using the said two machines according to the method claimed in the patent now sued upon from 1868 to 1873, and thereafter.

John J. Manning, Cross-Ints. 49–69, pp. 27–29 [*Tr. Rec.* pp. 19, 20].
Oliver C. Smith, Ints. 29–48, pp. 153–155 [*Tr. Rec.* pp. 105, 106].

The patent here in suit was issued January 7, 1873; and as no proof has been made of the exact date of the application therefor, it is to be taken as substantially the date of the patent itself. Hence it results that the alleged invention for which the said patent was granted had, before the application of the said James Manning therefor, been in public use for the purposes of gain in the regular course of business for nearly *thirteen years*, to wit: —

By Norwood & Manning from 1860 to 1867.

By C. Norwood & Son from 1867 to 1873.

By J. J. Manning & Brother from 1868 to 1873.

And it is a significant fact that this patent was taken for the benefit of James Manning's two sons, John J. Manning and William J. Manning, and his nephew, Caleb J. Norwood, all of whom had already used the invention for their own benefit from five to six years before his application.

Caleb J. Norwood, Cross-Ints 23–31, pp. 36, 37 [*Tr. Rec* pp 25, 26].

This state of facts bears a striking resemblance to that presented to this Court in a recent case, wherein it was held that

"The inventor cannot relieve himself of the consequences of the prior public use of his patented invention, by assigning an interest in his invention or patent to the person by whom the invention was thus used."

Worley v. *Tobacco Co.* 104 U. S. 340, 344.

[The points of law and fact raised by the appellants under this issue will be considered further on (*ut infra*, pp. 14, 45)].

II. Defence of want of novelty.

The facts upon which the second defence is based are briefly these : —

A machine provided with hollow rolls through which cold water was to be passed, to keep their surfaces cool while compressing isinglass into sheets, was described and patented by one Ebenezer Rowe in letters patent of the United States, No. 5,978, granted December 19, 1848.

Defendants' Exhibit No. 8, pp. 281–283 [*Tr. Rec.* pp. 192, 193].

The machine of this Rowe patent of 1848 was in all respects substantially the same as the machine described in the Manning patent of 1873 here in suit, except only that the latter has stationary scrapers applied thereto for clearing the adhering material from the surfaces of the rolls.

But the evidence shows that in the factory of the Rockport Isinglass Company, carried on by the firm of Gott & Giles, at Rockport, Mass., where machines constructed in accordance with the Rowe patent of 1848 were used from that date down to as late as 1876, scrapers called "spudgers," for clearing the adherent material from the rolls, were always used. Such scrapers were, however, not attached to the frame of the machine, but were fixed in the end of a wooden bar or lever, and were applied to the rolls by the hands of the workmen as occasion required.

James B. Rowe, Int. 2, p. 45 [*Tr. Rec.* p. 31]; Int. 5, pp. 45, 46 [*Tr. Rec.* p. 31]; Ints. 8, 9, p. 47 [*Tr. Rec.* p. 32].

Stephen Norwood, Ints. 2–5, pp. 69, 70 [*Tr. Rec.* p. 48]; Int. 11, p. 71 [*Tr. Rec.* p. 49].

And, during one season, at least, in the years 1858, 1859 or 1860, there was also used at the same factory a scraper which was mounted in a frame separate from that of the machine itself, and which was applied to the surface of the rolls by means of two levers grasped in the hands of a

workman, as represented by the model "Defendants' Exhibit No. 1."

James B. Rowe, Ints. 3, 4, p. 45 [*Tr. Rec.* p. 31]; Cross Ints. 50-53, pp. 55, 56 [*Tr. Rec.* p. 38].
Stephen Norwood, Ints. 12, 13, p. 71 [*Tr. Rec.* p. 49]; Ints. 17-19, p. 72 [*Tr. Rec.* p. 49].
Eben Rowe, Ints. 3-10, pp. 97, 98 [*Tr Rec* p. 67].
William Robbins, Ints. 3-10, pp. 108, 109 [*Tr. Rec* pp. 74, 75].

Moreover, stationary scrapers for clearing rolls from adhering material were well known and in common use long prior to the alleged invention of the appellants' patentee; as for instance in machines for crushing sugar or grinding pigments, like the model "Defendants' Exhibit No. 3."

James M. Parker, Ints 2-5. p. 164 [*Tr. Rec.* p 112].
John C. Gilbert, Ints. 2-5, pp. 165, 166 [*Tr. Rec.* p. 113].
John J. French, Ints. 7-11, pp. 167, 168 [*Tr. Rec.* pp. 114, 115].
George H. Morrill, Ints. 4-16, pp. 226-228 [*Tr. Rec.* pp. 154, 155]

And also for scraping glue or size from rollers upon which it was dried, as described in the patent of George Guenther, dated June 4, 1867, and printed on pages 284–286 of the record.

Transcript Record, pp. 194, 195.

Now in considering the question of novelty it is to be noted that the claim of the patent sued upon is not for a machine nor for an improvement upon a machine, but for a *method* or process.

The machine itself, apart from the stationary scrapers, was old and had been patented by Ebenezer Rowe in 1848. Machines with hollow rolls and stationary scrapers applied thereto were also old and well known. There could have been no invention, then, in applying stationary scrapers to the rolls of the specific machine patented by Ebenezer Rowe, to serve the old and well-known purpose of clearing their surfaces from adhering material.

The single question, therefore, is whether the patent in suit really describes any new method of treating isinglass to convert it into sheets; and this question in view of the evidence is resolved into the single inquiry, whether the employment of "stationary scrapers or clearers," instead of scrapers or clearers applied by hand, for removing the adhering sheets from the rolls, effects any substantial change in the *method* or process?

This question, as we confidently submit, should be decided in the negative; because the subject matter of the invention claimed is not the mechanical means for accomplishing the mode of treatment specified, but the series of operations which the patent denominates a "method," and which is to be clearly distinguished from the instrumentalities by which it is performed.

In a comparatively recent case this Court has stated the distinction as follows, MR. JUSTICE BRADLEY delivering the opinion: —

"A process is a mode of treatment of certain materials to produce a given result. It is an act or a series of acts performed upon the subject matter to be transformed and reduced to a different state or thing." . . .

"The process requires that certain things should be done with certain substances and in a certain order; but the tools to be used in doing this may be of secondary consequence."

Cochrane v. *Deener*, 94 U. S. 780, 788.

See also

Tilghman v. *Proctor*, 102 U. S. 707, 722, 728.

And accordingly when the claim of the patent — after specifying as its subject matter "The herein-described

method of converting isinglass into sheets of any desired thickness by running it between hollow rolls into which cold water is thrown to cool the compressing surfaces, such rolls being preferably made adjustable to graduate the degree of compression" (all of which description thus far was contained in the Rowe patent of 1848) — adds the further qualification, "and the adhering sheets being removed from the rolls," the entire method or mode of treatment is thereby completed whether this last stage of the process is performed "by stationary scrapers or clearers," or by any other scrapers or clearers which accomplish the result of so removing the adhering sheets from the rolls.

The specific attachments and supports by which the scrapers are held and applied affect only the *means* employed for clearing the rolls, and cannot alter the character of the *act*, which consists in the removal of the adhering material.

Hence it follows that the method claimed in the patent sued upon is substantially the same method as had for many years prior to the alleged invention of James Manning been practised by those who used the machine originally described in the patent of 1848 to Ebenezer Rowe.

[This subject will be discussed further on when we come to take up the appellants' points relating thereto (*ut infra*, pp. 45–58)].

III. Defence of non-patentability.

The third defence is that the claim of the patent in suit, although in terms for a method or process, is really for a function or mode of operation of a machine, and as such not patentable.

No attempt has been to claim the machine itself as new, nor was it in fact new, considering that its entire structure, aside from the stationary scrapers, was confessedly old; that the use of such scrapers in kindred machines for performing identically the same purpose of removing adhering material from the rolls was also old; and that their application to this particular machine required no change in the mode of adaptation.

But even if it were a patentable improvement to apply the old stationary scrapers of a sugar crusher or pigment grinder to the rolls of the old isinglass machine for performing the same purpose of clearing the surfaces of the rolls from adhering material in the same mode; there sûrely can be nothing patentable in the function which such scrapers perform, although the material operated upon may be isinglass instead of sugar or paint.

The process of converting isinglass into sheets by passing the crude material between adjustable hollow rolls cooled with water, and by clearing the same from the surface of the rolls, when it adhered thereto, with scrapers applied by hand, was old and well known, as we have proved; and the question here for consideration is whether making the scrapers automatic in their operation works a substantial change in the process or simply gives the machine an additional function to perform without adding anything to the series of operations which constituted the old process.

A man cannot have a valid patent for doing by machinery just what had before been done by hand. If he has devised new mechanism he may take a patent for that, but he cannot convert an old method or process into a new one, merely by performing its operations automatically.

The distinction between a process and the mode of operation of a machine is thus defined by the Supreme Court, Mr. Justice Grier delivering the opinion: —

"It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

"But the term process is often used in a more vague sense in which it cannot be the subject of a patent. Thus we say, that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means or the use of a machine, as distinguished from a process.

"In this use of the term it represents the function of a machine or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it."

Corning v. *Burden*, 15 Howard, 252, 268.

So in the case at bar: the claim of the patent sued upon to "the method of converting isinglass into sheets of any desired thickness" by the employment of a machine therefor possessing certain specific features of construction, namely, hollow rolls, cooled by water, made adjustable and provided with stationary scrapers, is virtually a claim to a process which is characterized not by anything intrinsic in the treatment which the material itself undergoes, but rather by the fact that the operations are performed by mechanical means which possess certain peculiarities of construction. That is to say: the term method is used to signify merely the functions of the machine, and its alleged novelty is made

to depend upon the single feature of the automatic action of the scrapers applied to the rolls.

Subjectively considered it may be called a process of automatically scraping the material from the surface of the rolls; but that is not a patentable process: it is merely the function or mode of operation of the stationary scrapers acting in combination with the rolls.

If regarded as a process, properly so called, it must be independent of the specific mechanical means by which it is carried out, and in this case also independent of the character of the material acted upon.

This court has held that the method of freezing ice cream does not become new by reason of its application to freezing fish, and that the process of canning fresh vegetables in general does not derive novelty by being applied to green corn.

Brown v. *Piper*, 91 U. S. 37, 41, 43.
Sewall v. *Jones*, 91 U. S. 171, 182.

How then, in view of the old sugar-crushing machines provided with stationary scrapers, can there be a valid patent for automatically scraping isinglass from the surface of compressing rolls by the same means and in the same mode that were employed for sugar?

Consideration of Appellants' Points.

Judging from the brief and argument on behalf of the complainants in the court below, we may with approximate accuracy anticipate the points which will here be taken by the appellants, and will proceed to deal with the same as definitely as we can without access to the brief to be filed in support of this appeal.

Appellants' attempted reply to the defence of more than two years' public use before patentee's application.

Of course the appellants will direct their principal assignment of errors to the opinion of the court below, which founded the decision upon the single defence that the patented invention had been in public use in this country for more than two years before application for the patent, and that therefore it had been forfeited under the statute.

The fact of the use of isinglass machines containing hollow rolls cooled with water and provided with stationary scrapers by Norwood & Manning from 1860 to 1867, and by C. Norwood & Son from 1867 to 1873 and thereafter, in the Ipswich factory, and by J. J. Manning & Brother from 1868 to 1873 and thereafter in the Rockport factory, is not only undisputed, but is positively admitted by the appellants themselves.

John J. Manning, Cross-Ints. 25-84, pp. 24-31 [*Tr. Rec.* pp. 17-22].
Caleb J. Norwood, Ints. 1-12, pp. 33-35 [*Tr. Rec.* pp. 23, 24].

Consequently the complainants can only hope to avoid the statutory forfeiture by showing either (1) that such use prior to 1871 was not public, or (2) that it was experimental, or (3) that it was of something substantially different from what has been patented.

And upon each of these propositions the court below has explicitly found the evidence to be against the appellants.

It says: —

"I have read the case with care, and am of opinion that the use at the factories in Ipswich and Rockport was a public use in the sense of the law, and was not for the purposes of experiment; and that the use was of the same improvement which is patented."

Transcript Record, p. 215.

These three points we will now take up in the order indicated; remarking at the outset that as to the first two of them the burden of proof is undoubtedly upon the appellants.

I. The use was public within the meaning of the statute.

Whatever may be said about the use of the invention in controversy by James Manning while he remained a member of the firm of Norwood & Manning, from 1860 to 1867, it cannot be disputed that he did not participate in the use of the machine by which that invention was practised after it became the property of Caleb Norwood, at the dissolution of the copartnership in 1867, and during its use by C. Norwood & Son thereafter.

Hence it results that the invention was in use for *six years* before the application for the patent in suit by other persons than the alleged inventor and in a factory over which he had no control!

So far as he was concerned such use was as foreign to him as if the users had been utter strangers. To all intents and purposes C. Norwood & Son were a part of the public, and their use was a public use.

Furthermore, although James Manning, the said alleged inventor, owned the Rockport factory and the machinery therein where John J. Manning and William N. Manning carried on business from 1868 onwards; yet he did not participate in their business, and consequently the use of the invention in controversy was by them and not by him.

Upon this point the testimony of John J. Manning, one of the appellants, is as follows:

"*Cross-Int.* 66. Did the said James Manning have any interest in the business of manufacturing isinglass carried on by yourself and William N. Manning at said factory from 1868 to 1871?

Ans. He did not. He owned the factory and machinery and worked there by the day for William N. Manning and myself."

John J. Manning, Dep. p. 29 [*Tr. Rec.* p. 20].
See also Cross-Ints. 73–84, pp. 30, 31 [*Tr. Rec.* pp. 21, 22].

Here, then, is three years' use beyond the period allowed by statute; and that, too, not by the alleged inventor himself, but by others for their own purposes of gain. To be sure, they were his sons; but they were also members of the community which, when contradistinguished from him as a private individual, constituted the public. Their use was in no sense his private use. He did not participate in it nor share the profits of it; and so far as the question of public use is concerned the situation would not have been changed if they had been wholly unrelated to him by blood.

Public use of an invention may be either by the inventor himself in the presence of others who belong to the community which constitutes the public, or by some member or members of such community other than the inventor. In the first instance the use is *in public;* in the second instance it is *by the public;* and the courts recognize each of these forms of public use as within the meaning of the statute.

Among the cases illustrative of a use in public by the inventor himself, are the following: —

Worley v. *Tobacco Co.* 104 U. S. 340, 343.
McClurg v. *Kingsland*, 1 How. 202, 205.
Toppan v. *Natl. Bank Note Co.* 4 Blatchf. 509, 510.
Sanders v. *Logan*, 2 Fisher's Pat. Cas. 167, 172, 173.
McMillin v. *Barclay*, 5 Fisher's Pat. Cas. 189, 197.
Perkins v. *Nashua Card, etc., Co.* 2 Fed. Rep. 451, 452.

And among the cases where the use was by another or by others not under the control of the inventor, the following may be cited: —

Consolidated Fruit Jar Co. v. *Wright*, 94 U. S. 92, 96.
Egbert v. *Lippmann*, 104 U. S. 333, 336.
Hall v. *Macneale*, 23 Off. Gaz. 937, 938 [Sup. Ct. U. S.].
Bell v. *Daniels*, 1 Bond, 212, 217, 218.
Am. Hide, etc., Co. v. *Am. Tool, etc., Co.* 1 Holmes, 503, 510, 511.
Sisson v. *Gilbert*, 9 Blatchf. 185, 187.
Henry v. *Providence Tool Co.* 14 Off. Gaz. 855, 859.

In the case at bar, the use of the patented method of making isinglass into sheets by Caleb Norwood and his son, Caleb J Norwood, for *six years* before James Manning's application for the patent in suit; and the use of the same method by John J. Manning and William N. Manning for *five years* before that application, was in like manner a use *by the public*, because the users were members of the public body of citizens, carrying on business independently of the inventor, who alone could have practised a private use.

This is sufficient to justify the decree of the court below; but the evidence further shows that the use of the patented method by James Manning and Caleb Norwood, as copartners, under the firm name of Norwood & Manning, from 1860 to 1867, was also a public use in the sense of having been a use *in public:* that is to say, in the presence of others who belonged to the community constituting the public.

In a subsequent case decided by the same court, JUDGE LOWELL took occasion to refer to the case at bar and to state that his "opinion was that the use by the firm before they dissolved their partnership was a public use."

Perkins v. *Nashua Card, etc., Co.* 2 Fed. Rep. 451, 453.

But the appellants have introduced evidence tending to show, and they will probably contend, as they did in the court below, that both the Ipswich factory from 1860 to 1873 and the Rockport factory

from 1868 to 1873 were not open to the public indiscriminately, and that pains was taken to exclude those who might be or become rival manufacturers.

This is certainly immaterial so far as concerns the Ipswich factory while C. Norwood & Son carried on business there from 1867 to 1873, or the Rockport factory where J. J. Manning & Brother carried on business from 1868 to 1873; because if the statute did not run against the inventor by reason of one or two independent persons practising the invention with closed doors, then there is no reason why the statute should run if all the manufacturers in the country practised the invention, provided only that they kept their factories shut against outsiders.

The use of an invention ceases to be private and becomes public within the meaning of the statute whenever the inventor himself does not directly or indirectly participate in it.

And even when he does so participate in the use of his invention, such use becomes a public use against which the statute will run if it takes place in the presence of others whose interests in respect thereto are the same as those of the public generally, and if it is done for gain in the ordinary way of business and not merely as *bona fide* experiment for the purpose of perfecting the invention itself.

The principal witnesses to the long and continued use of the invention in controversy, extending over a period of thirteen years before the application for the patent in suit, are, of course, former workmen in the Ipswich and Rockport factories; and it was contended by the complainants in the court below that as a court of equity will protect a secret manufacture against workmen who, in violation of contract or by breach of confidence, undertake to practise it or to disclose it to third persons; the inference to be derived from this principle of law was that the use of an invention in the presence of workmen employed by the inventor colud not be a public use.

Such a conclusion, however, by no means follows. The establishment of the patent law was not to protect secret inventions, but to reward inventors who should with reasonable promptness disclose their inventions to the public in full, clear and exact terms.

This court has expressed itself with emphasis upon the subject both before and since the enactment of the law of 1839 allowing the inventor two years within which to practise his invention prior to his application for a patent.

(Act of 1839, ch. 88, sect. 7, 5 Stats. at Large, 354.)

In a case decided in 1829 Mr. Justice Story, delivering the opinion of the court, said: —

"If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should for a long period of years retain the monopoly, and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure; and then and then only when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent and thus exclude the public from any further use than what should be derived under it during his fourteen years; it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries."

Pennock v. *Dialogue*, 2 Peters, 1, 19.

And in a case decided in 1858 the opinion of the court, delivered by Mr. Justice Daniel, contained the following language:—

"It is undeniably true, that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing that monopoly. This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects. The true policy and ends of the patent laws, enacted under this government, are disclosed in that article of the Constitution, the source of all these laws, viz.: 'to promote the progress of science and the useful arts,' contemplating and necessarily implying their

extension and increasing adaption to the uses of society (*vide* Constitution of the United States, art. 1, sec. 8, clause 9).

By correct induction from these truths, it follows that the inventor who designedly and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and if aided in his design would impede the progress of science and the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had neither benefited nor intended to benefit."

Kendall v. *Winsor*, 21 Howard, 322, 327, 328.

It may safely be concluded, therefore, that the court will not assist the inventor to escape the statutory forfeiture by holding that his use of his invention cannot be public so long as it takes place only in presence of his workmen; for if such were the law there would be no limit to the time during which an inventor might not practise his invention for his own profit, without losing his right to a patent, provided he made application within two years after some outside competitor began to use the same.

We confidently submit, then, that in the case at bar, the testimony of former workmen in the Ipswich factory of Norwood & Manning that the use of the appellants' patented invention there between 1860 and 1867 was known to them and took place in their presence, is of itself evidence of the public use of such invention, irrespective of the further proof that the factory was visited by others belonging to the public community; and this applies *à fortiori* to the similar testimony of those who were employed in the Ipswich factory from 1867 to 1873 and in the Rockport factory from 1868 to 1873, and who were not workmen of James Manning, the alleged inventor, in any sense, since he had no interest whatsoever in the business carried on there.

These isinglass factories were run only during the winter season, because warm weather was very unfavorable for the manufacture.

Each of the factories employed about a dozen workmen at a time, and among these there would usually be new hands every year.

John J. Manning, Cross-Ints. 96, 97, p. 33 [*Tr. Rec.* p. 23].
Caleb J. Norwood, Cross-Ints. 46-48, p. 39 [*Tr. Rec.* p. 27].

The complainants have not called any of these workmen to testify on their behalf in relation to this matter, but they have only offered their own testimony, to which of course must be attributed such bias as attaches to parties in interest.

John J. Manning, one of the complainants, testifies of the factory of Norwood & Manning, at Ipswich: —

"It was not open to the public, and none but the operatives were admitted when I was in their employ."

Ans. to Int. 87, p. 31 [*Tr. Rec.* p. 22].

Caleb J. Norwood, the other complainant, however, does not confine its accessibility to the operatives only; for he testifies: —

"Well, we never allowed any strangers in the mill. We live in an out-of-the-way place and no one was allowed in *except those that lived right round handy*. If a stranger came there he could n't get in, neither then nor now."

Ans. to Int. 14, p. 35 [*Tr. Rec.* p. 24].

But we shall see from the evidence introduced on behalf of the defendants that many others besides workmen and neighbors were admitted, and that in fact there was no attempt made to keep the machinery and manufacture from the eyes of the public.

Henry Dennis, Jr., testifies that in February, 1865 or 1866, being then one of the selectmen and overseers of the poor, and being detained in Ipswich, he called at the factory of Norwood & Manning, between eight and ten o'clock in the morning, to visit a friend who worked there; that the mill was in operation at the time, and the door not locked; that he opened it, walked in alone and unannounced, saw people at work there and the rolls going round; that

he had conversation with several persons there whom he knew; and that no objection was made to his presence.

Ints. 10 to 23, pp. 127–129 [*Tr. Rec.* pp. 87, 88]; Cross-Int. 25, p. 129 [*Tr. Rec.* p. 89].

Benjamin Tarr, 2d, a workman employed in the factory of Norwood & Manning in 1862, 1863 and 1864, testifies that occasionally, once or twice each winter, he saw strangers and visitors there, three or four at a time, who so far as he knew were inhabitants of the place around; that they were in the same room where the rolls were in operation and appeared to be looking about from idle curiosity; and that some of these visitors were ladies.

Ints. 7 to 12, p. 131 [*Tr. Rec.* p. 90]; Cross-Int. 18, p. 132 [*Tr. Rec.* p. 90].

Charles B. Morse, a workman employed in the same factory in 1864, 1865, 1866 and 1867, testifies that he occasionally saw visitors there, talking and walking around in the working room when the rolls were in operation; although he cannot remember any others than those who lived close by.

Ints. 6 to 9, p. 148 [*Tr. Rec.* p. 101]; Cross-Ints. 14 to 19, pp. 148, 149 [*Tr. Rec.* p. 102].

Oliver C. Smith, the machinist who made the rolls for this factory and applied the stationary scrapers thereto in 1859 or 1860, testifies that he was there for repairing the machinery several times each winter for quite a number of years; and that he remembers seeing several of the neighbors in there to see what was going on.

Int. 53, p. 156 [*Tr. Rec.* p. 107]; Cross-Ints. 75 to 83, p. 159 [*Tr. Rec.* p. 109].

Joseph H. Hillard, Jr., a workman employed at the factory of Norwood & Manning, at Ipswich, in 1861, 1862 and 1863, and also in 1865, 1866 and 1867, testifies that strangers or visitors were there once or twice a week as they had a mind to come in; that there were a good many farmers who came in to look at the work and see how isinglass was made; that he ordinarily saw such visitors

in the room where the machinery was; and that the rolls were in operation during such times.

Ints. 11 to 15, p 256 [*Tr. Rec.* p. 175]; *see also* Cross-Ints. 34 39, pp 258, 259 [*Tr. Rec.* p. 176].

It is very evident, then, from the testimony of these five witnesses, that the factory of Norwood & Manning was frequently visited by those who lived in the neighborhood, and was as open and accessible to the public as any ordinary workshop.

A single instance is mentioned of the attempted exclusion of one person, Ebenezer Rowe, the superintendent of Gott & Giles' Rockport factory and the inventor of the water-cooled hollow rolls patented to him in 1848, between whom and Caleb Norwood there was ill feeling.

James B. Rowe, Cross-Int. 51, p. 55 [*Tr. Rec.* p. 38].
Stephen Norwood, Ints. 6, 7, p. 70 [*Tr. Rec.* p. 48].
Benjamin Tarr, 2d, Cross-Int. 19–22, p. 132 [*Tr. Rec.* pp. 90, 91]; Ints. 23–27, p. 133 [*Tr. Rec.* p 91].
Joseph H. Hillard Jr., Cross-Ints. 40–42, p. 259 [*Tr. Rec.* pp. 176, 177].

But there does not appear to have been any restriction put upon the admission of anybody who was not personally obnoxious to the proprietors, — not even the customary precaution taken by manufacturers in general for keeping out loafers by a sign "no admittance" on the door.

Henry Dennis, Jr., Int. 24, p. 129 [*Tr. Rec.* p. 88].
Charles B. Morse, Int. 13, p. 148 [*Tr. Rec.* p. 102].
Oliver C. Smith, Ints. 54, 55, p. 156 [*Tr. Rec.* p. 107].
Joseph H. Hillard, Jr., Int. 26, p. 257 [*Tr. Rec.* p. 176].

The significant and conclusive fact, however, is that the rolls which had the stationary scrapers attached were treated no differently from the other machinery in respect to publicity. They were in the same general work room with the rest of the rolls and were used there in the ordinary way of business as a part of the plant by which the manufacture of isinglass was carried on.

Henry Dennis, Jr., Int. 14, p. 128 [*Tr. Rec.* p. 87].
Benjamin Tarr, 2d, Ints. 11, 13, 14, pp. 131, 132 [*Tr. Rec.* p. 90].
Charles B. Morse, Ints. 8–10, p. 148 [*Tr. Rec.* p. 101].

Oliver C. Smith, Int. 40, p. 155 [*Tr. Rec.* p. 106],
Cross-Int. 81, p. 159 [*Tr. Rec.* p. 109].
Joseph H. Hillard, Jr., Ints. 14-16, p. 256 [*Tr. Rec.* p. 175].

The foregoing evidence relates to the public use of the alleged invention of James Manning at the Ipswich factory from 1860 to 1867, while the firm of Norwood & Manning continued; and as further evidence tending to show how business was carried on at that factory, it may be worth while to consider the testimony relating to the later period from 1867 to 1873, after the firm of Norwood & Manning had dissolved and the firm of C. Norwood & Son had come into possession of the same machinery; although we contend, as already stated, that since James Manning had no participation in the use of his alleged invention by the latter firm, such use was necessarily a public use.

And first we have additional evidence that in this Ipswich factory the main entrance opened into the room where all the rolls were operated, including those which had the stationary scrapers attached.

Stephen Norwood, Int. 28, p. 73 [*Tr. Rec.* p. 50],
Ints 207-211, p. 95 [*Tr. Rec.* p. 65].
James H. Stevens, Ints. 11-17, pp. 134, 135 [*Tr. Rec.* p. 92].
Esrom Morse, Ints. 11, 12, p. 140 [*Tr. Rec.* p. 96].

Caleb J. Norwood, one of the complainants, testifies the same in reference to the time during which the business was carried on by C. Norwood & Son as he did with respect to the previous time while the firm of Norwood & Manning continued, namely that "no one was allowed in except those that lived right round handy."

Int. 14, p. 35 [*Tr. Rec.* p. 24].

Stephen Norwood, an old isinglass manufacturer, who was employed at the Ipswich factory by C. Norwood & Son in 1868 and 1869, testifies that he never knew of any restriction being made to visitors going into the factory, and that he saw visitors there quite often.

Ints. 44 to 46, pp. 75, 76 [*Tr. Rec.* p. 52].

In fact, it will be seen from the following testimony of this witness on cross-examination that this factory was open to anybody who might choose to drop in: —

Cross-Int. 156. Do you remember of any business these visitors had in the factory, or anything that any of them did there?

Ans. To appearance they did not have any business there; merely called in, loafers, out and in.

Cross-Int. 157. Didn't it ever strike you as queer that there should be such a lot of men and women loafers in and around that factory two miles from Ipswich?

Ans. Why, no, for the reason they were drawing in timber there. There was a grist mill and saw mill close by, and they would call in occasionally.

Cross-Int. 158. When these visitors called in, dropping over across from the grist mill and saw mill, they generally went to that part of the factory where the fire was, didn't they, in this winter weather?

Ans. Well, I don't know as I can say they did more than to any other part. I did not notice them.

Cross-Int. 159. You never noticed any one near the mumming rolls, did you, except the workmen, so far as you now remember?

Ans. I could not say any one was very near, nearer than to the other rolls. Couldn't say they were or were not. Did not take particular notice, probably.

Cross Int. 160. You don't know, do you, where any one of these visitors went that came into the factory, as you say?

Ans. Well, I did not keep track of them. They would come in and walk around, and go out and come in again and stay awhile. It was a common occurrence. They would come in and walk about. I did not take particular notice.

Stephen Norwood, Dep. p. 89 [*Tr. Rec.* p. 61]; *see also* Ints. 203–206, pp. 94, 95 [*Tr. Rec.* p. 65].

James H. Stevens, a former workman in C. Norwood & Son's Ipswich factory, testifies that he was employed there in 1869 and thereafter four successive seasons; that he saw strangers or visitors there several times each winter; that C. Norwood & Son carried on a saw mill and grist mill near by; and that it was the habit of farmers and others having work to be done at either of these mills to occasionally come into the isinglass factory in search of Mr. Norwood.

Ints. 6 to 8, p. 134 [*Tr. Rec.* p. 92]; Ints. 15-19, p. 135 [*Tr. Rec.* pp. 92, 93]; Cross-Ints. 33–39, p. 137 [*Tr. Rec.* pp. 93, 94].

Esrom Morse, who was employed in this same factory for about eleven years up to 1878, which would carry his service back to about 1867, testifies that during Caleb Norwood's lifetime (*i. e.*, before 1870) he occasionally saw strangers there; that they appeared to be farmers at the mill; and that they were generally in the room where the rollers were.

Ints. 9–11, pp. 138, 140 [*Tr. Rec.* pp. 95, 96]; Cross-Ints. 28–30, pp. 141, 142 [*Tr. Rec.* p. 97].

Joseph Spiller, a deputy sheriff, testifies that prior to Caleb Norwood's death in 1870, he had frequent occasions in the course of his business to visit this Ipswich factory; that no one ever objected to his going in; that he never found the door locked; and that most of the times when he was there the factory was in operation.

Ints. 2-7, p. 162 [*Tr. Rec.* p. 111].

Joseph H. Hillard, Jr., who was not only employed at this Ipswich factory before the dissolution of the firm of Norwood & Manning, but also afterwards, while the business was carried on by C. Norwood & Son, down to and including 1870, testified as follows: —

Int. 12. While you were employed at the Ipswich factory, state whether strangers or visitors were at the factory at times; and if so, how frequently?

Ans. Yes, sir; well, most any time they were a mind to come in; once or twice a week; as they were a mind to come in.

Int. 13. State what such strangers or visitors appeared to be doing, as nearly as you can tell.

Ans. Well, I suppose they came in to look at the work, — see how isinglass was made; there were a good many farmers.

Int. 14. In what room of the factory did you ordinarily see such visitors?

Ans. Well, mostly where the machinery is, and sometimes in the drying room.

Int. 15. And were the rolls in operation during such times?

Ans. Yes, sir.

Joseph H. Hillard, Jr., Dep. p. 256 [*Tr. Rec.* pp. 174, 175].

As to the question whether or not there was a sign, "no admittance," on the outer door, *James H. Stevens*, who worked there from 1869 during four seasons, testifies that he has an impression he has

seen those words on one of the doors; *Esrom Morse*, who was employed there from 1867 onward, testifies that the words were on the outer door; *Charles B. Morse*, who worked there one season after the dissolution of the firm of Norwood & Manning, testifies that he don't remember any such sign; *Joseph Spiller*, who used to visit the factory while Caleb Norwood was alive, does not recollect that there was; and *Joseph H. Hillard, Jr.*, who was employed in that factory consecutively from 1865 to 1870, testifies positively that there never was any sign, "no admittance," while he worked there.

James H. Stevens, Cross-Ints. 41, 43, p. 138 [*Tr. Rec.* p. 94].
Esrom Morse, Cross.Int. 31, p. 142 [*Tr. Rec.* p. 97].
Charles B. Morse, Ints. 12, 13, p. 148 [*Tr. Rec.* pp. 101, 102].
Joseph Spiller, Int. 9, p 163 [*Tr. Rec.* p. 111].
Joseph H. Hillard, Jr., Int. 26, p. 257 [*Tr. Rec.* p. 176].

This is at best only a possibility that such a sign was used by C. Norwood & Son, and is no evidence that Norwood & Manning ever had it. Besides, the existence of such a sign upon the outer door of a factory has but very little to do with the question of public use of a machine operated in the general workroom along with other machinery about which there is no pretence of privacy.

The following language of JUDGE SHIPMAN, in a case decided by him and JUDGE WOODRUFF in the Second Circuit, is pertinent to this point: —

"His notice, on the door of his factory, that no one could enter without permission, is of still less consequence as evidence of his intention to pursue a claim for a patent. Such notices are common on the doors of manufactories. They are as often put up to keep out idlers, as to conceal unpatented inventions."

Bevin v. *East Hampton Bell Co.* 9 Blatchf. 50, 54, 56.

There remains now the further inquiry as to the publicity of the business carried on by J. J. Manning & Brother, in the factory of their father, James Manning, at Rockport, from 1868 to 1873.

This inquiry we believe to be immaterial, on the ground that, as matter of law, the use of the invention in controversy by the sons of the alleged inventor, without his participation or control, and for their own profit, necessarily constituted a public use within the meaning of the statute.

James J. Manning, one of the appellants, testifies that since his occupation of James Manning's Rockport factory, "there has been no admittance of per-ons unemployed there."

Int. 89, p. 32 [*Tr. Rec.* p. 22].

And as this applies to several years since the date of the patent sued upon, as well as five years prior to that date, the testimony only shows that no departure from the usual course of business was made on account of the alleged invention while yet it was unpatented.

Oliver C. Smith, the machinist, under whose control and supervision the rolls with scrapers were built and fitted, testifies that he was employed about six weeks in setting up the machinery at James Manning's factory, at Rockport; that during this time the doors were open and any one could come in who wished to; and that no secrecy was enjoined upon him by James Manning in relation to these rolls and scrapers.

Ints. 43-46, p. 155 [*Tr. Rec.* p. 106].
2d Dep. Int. 1, p. 228 [*Tr. Rec.* p. 155].

Indeed, the absence of all evidence that James Manning, the alleged inventor of the subject matter of the patent in suit, ever took the slightest pains to keep the same secluded, or laid any injunction of secrecy upon any workman, taken in connection with the fact that the machines, by means of which such invention was practised, were put in the same general workroom where the rest of the machinery was located, and were used in the same way for the ordinary purposes of business, and that too, not by the alleged inventor himself, but by others wholly independent of him, makes the proof conclusive that the use was not and could not have been a private use in any sense.

Moreover, the behavior of James Manning in relation to his said alleged invention during its long-continued use, and the circumstances under which the patent in suit was obtained, make evident the fact that there was never any intention of taking such a patent until within a very short time before its actual procurement; that then it was obtained as a possible means of deterring competitors from using the invention; and that the patentee was conscious of the invalidity of the patent so procured.

The evidence shows that James B. Rowe, one of the defendants in the case at bar, and at the time this suit was brought the superintendent of the Cape Ann Isinglass and Glue Company, the defendant corporation, had been a workman in the employ of J. J. Manning & Brother, at their Rockport factory, just after they started business there in 1867 or 1868, and worked at the rolls which were provided with the stationary scrapers. In other words, he practised the invention in controversy at their factory five years or more before the issue of the patent here in suit.

James B. Rowe, Int. 11, p. 47 [*Tr. Rec.* pp. 32, 33]; Ints. 29, 30, pp. 51, 52 [*Tr. Rec.* pp. 35, 36]; Cross-Int. 104, p. 62 [*Tr. Rec.* p. 42].

Accordingly, when the defendant corporation prepared to start the same business in the fall of 1872, its superintendent, the said James B. Rowe, caused certain of its rolls to be provided with stationary scrapers, and proceeded to use the same.

James B. Rowe, Int. 12, pp. 47, 48 [*Tr. Rec.* p. 33].

When the intention of the defendant corporation to use such scrapers on its rolls became known to John J. Manning, one of the complainants, he signified to the said James B. Rowe his objections thereto, and claimed to have a patent for the same. But as this is said to have taken place in November, 1872, it was before the patent in suit had been issued.

Reuben Norwood, Ints. 3–6, p. 16 [*Tr. Rec.* pp. 11, 12].
John J. Manning, Ints. 19, 20, p. 23 [*Tr. Rec.* p. 16].
James B. Rowe, Int. 27, pp. 50, 51 [*Tr. Rec.* pp. 34, 35].

Manifestly, then, this patent was applied for at the instance of the complainant, John J. Manning, in view of the prospective competi-

tion of the defendant corporation; and if no such competitor had arisen, the patent would probably not have been taken to this day.

And it is reasonably certain that James Manning and his sons, John J. Manning and William N. Manning, had no confidence in the validity of the patent so procured; for otherwise they would not have been likely to give away one half of it at the outset to Caleb J. Norwood as they did for the merest nominal consideration.

Caleb J. Norwood, Cross-Ints. 19-32, pp. 36, 37 [*Tr. Rec.* pp. 25, 26].

If James Manning had had at that time the full right to such a patent as the one here in suit purports to be, the right must have been exclusive even as against his own sons. If the patent was valid, he could have prevented his nephew, Caleb J. Norwood, from using the invention in connection with any other machine than the one which was derived from the firm of Norwood & Manning at its dissolution in 1867; and at any rate the right of the nephew would be that of a mere licensee.

While, therefore, James Manning might, for paternal regard, have chosen to give the entire benefit of this patent to his sons, John J. Manning and William N. Manning, there was no earthly reason why he should have assigned one half of it for nothing to their competitor in business, Caleb J. Norwood, except for the purpose of making it for the interest of the latter to uphold the validity of the patent, which he was able to destroy by proof of his own public use of the patented invention more than two years before the application for such patent; and the conclusion is inevitable that this patent was so procured and assigned with the knowledge that it was invalid, but with the hope and intent of setting it up as a barrier against the further spreading of the free use of the invention among other manufacturers of isinglass.

Summing up the evidence upon this question of public use, in the Ipswich factory of Norwood & Manning from 1860 to 1867, and of C. Norwood & Son from 1867 to 1873, we find: —

First. That the machine containing the rolls with stationary scrapers were located alongside of the other machines employed in

the manufacture, and was used together with them in the ordinary way of business.

Second. That the main entrance to the factory opened into the general work room where these rolls with stationary scrapers and the rest of the machinery were.

Third. That such main entrance was open at all times when the factory was in operation.

Fourth. That a dozen workmen were employed at the factory during each winter season, and that among these were new hands from year to year.

Fifth. That but one workman at a time was needed to tend the mumming rolls which had the scrapers on, and that, consequently, the presence of the other workmen was inconsistent with any pretence of keeping the use of such rolls secret.

Sixth. That neighbors, living in the vicinity of the factory, and farmers, and others coming to the saw mill and grist mill near by, were accustomed to visit the room, where these rolls with scrapers were in operation, freely and frequently.

Seventh. That no injunction of privacy was put upon the workmen or any one else in respect to these rolls with scrapers attached.

Eighth. That no attempt was made to exclude anybody from the factory, except in the single case of the superintendent of another isinglass factory, who was personally obnoxious to Caleb Norwood.

As to the Rockport factory of J. J. Manning & Brother, from 1868 to 1873, we find the 1st, 2d, 3d, 4th, 5th, and 7th foregoing specifications in relation to the Ipswich factory to be likewise true of this.

And to crown all these facts we find further: —

Ninth. That no indication was ever made of any intention to take a patent for the invention in controversy until one of the defend-

ants who, five years before, had practised the invention as a workman in the factory of J. J. Manning & Brother, began to prepare to use it independently of them.

Tenth. That the patent, when taken, was assigned to the very persons whose prior public use had, in fact, deprived it of any validity.

II. The use was not experimental.

Some feeble attempt was made on the part of the complainants to show that the thirteen years' use of the invention in controversy by Norwood & Manning, C. Norwood & Son and J. J. Manning & Brother was experimental by reason of certain alleged changes from time to time in the mode of application of the stationary scrapers to the rolls.

In support of this point there is only the testimony of the complainants themselves, and even that is for the most part very trivial. John J. Manning testifies that but one scraper was originally used on the mumming rolls at the Ipswich factory of Norwood & Manning; that its position was changed after use one or two seasons; and that then it was so used about six years with some slight changes.

John J. Manning, Cross-Ints. 29-39, pp. 25, 26 [*Tr. Rec.* pp. 17, 18].

By implication, however, he admits that both rolls of the set had scrapers attached at the time of the dissolution of the firm of Norwood & Manning, when they became the property of Caleb Norwood; and this fact is explicitly admitted by the other complainant, Caleb J. Norwood.

John J. Manning, Cross-Ints. 47, 48, p. 27 [*Tr. Rec.* p. 19].
Caleb J. Norwood, Ints. 3-8, pp. 33, 34 [*Tr. Rec.* pp. 23, 24].

But the complainant, John J. Manning, who alone testifies that there was originally only one scraper upon the mumming rolls at the factory of Norwood & Manning in 1860, and for several years thereafter, is entirely mistaken; for the machinist who made the rolls and the workmen who saw them during this time, all testify that

they were provided with two scrapers, either by designating them in the plural, or by specifically mentioning them as attached to each roll, or by reference to Exhibit A, the model of the machine described in the patent in suit.

Oliver C. Smith, Ints. 10–13, p. 151 [*Tr. Rec.* pp. 103, 104]; Int. 28, p. 153 [*Tr. Rec.* p. 105].
Benjamin Tarr, 2d, Ints. 13, 14, pp 131, 132 [*Tr. Rec.* p. 90].
Charles B. Morse, Int. 10, p. 148 [*Tr. Rec.* p. 101].
Joseph H. Hillard, Jr., Int. 16, p. 256 [*Tr. Rec.* p. 175].

The machinist who made and applied them in 1860 testifies so explicitly in respect thereto, that no reasonable doubt can be had that the machine was in all respects substantially the same as that described in the patent sued upon. His testimony on this subject is as follows: —

Int. 13. Who made these scrapers? and please describe them and the manner in which they were appled to the rolls.

Ans. They were made in the shop by my men. The scraper on the back of the machine was bolted stationary. The forward scraper was bolted to the boxes of the movable roller.

. . . . . .

Int. 28. Look at the model marked "Exhibit A," and at the scrapers therein shown, and say how the scrapers which you made in 1860 for Norwood & Manning compare in form and mode of application to the rolls with them.

Ans. They are substantially the same.

. . . . . .

Cross-Int. 89. Are you quite sure that of the first scrapers that you made for Manning & Norwood, one was bolted to the boxes of the movable roller?

Ans. Yes, sir.

Cross-Int. 90. You say that the other scraper was bolted stationary. What do you mean by that?

Ans. That it was not movable — that the arms were not movable. The scraper itself could be altered as it wore away.

Cross-Int. 91. Please give me the exact construction of this scraper and the arms, — how the scraper was fastened to the arms and how and to what the arms were secured.

Ans. The scraper had a slot in each end through which a bolt screwed

into the arm; the arms were bolted on to the movable boxes on the front end, and the back arms were bolted either to the boxes or the bed-piece.

. . . . . .

Cross-Int. 97. At what angle, and in what position in relation to the rolls, were these scrapers which you first applied at the factory of Manning & Norwood?

Ans. They were calculated to stand pointing to the centre of the roller and up high enough above the boxes so as to be adjustable and so that the bolts could be easily got at.

Cross-Int. 98. Was the edge of the scraper on the same plane above or below the back thereof?

Ans. The front edge of the scraper that struck the roll was bevelled on the top side down to a thin edge.

Cross-Int. 99. Please state whether or not either of the scrapers was inclined in relation to the roll as shown in complainants' Exhibit A.

Ans. It was substantially the same; the direction of the scraper pointed to the centre of the roller, but it might have been placed higher up or lower down than the model represents.

Oliver C. Smith, dep. pp. 151, 153, 160, 161 [*Tr. Rec.* pp. 103-105, 109, 110]. *See also*, Oliver C. Smith (recalled), Int. 8, p. 229 [*Tr. Rec.* 156].

Moreover, this witness is corroborated in the main by Caleb J. Norwood, one of the complainants, who testifies in respect to the construction of the machine when it came into the possession of C. Norwood & Son, in 1867, and during its use from that time down to 1872, and who does not remember that it had ever undergone any changes or alterations before the dissolution of the firm of Norwood & Manning.

Caleb J. Norwood, Ints. 3-9, pp. 33, 34 [*Tr. Rec.* pp. 23, 24].

His testimony is that "the mumming rollers or sheeting rollers had knives on the rollers; there was one fastened to the box, and the other fastened to the bed."

Caleb J. Norwood, Int. 6, p. 34 [*Tr. Rec.* p. 23, 24].

And again he testifies as follows:—

"*Cross-Int.* 35. In your answer to the sixth and seventh interrogatories you mention knives fastened to the box and bed respectively, of the mumming rolls: will you describe these knives a little more particularly and their operation?

Ans. Similar to those (Exhibit A), only one was on the stationary roller, and the other was on the bed, and neither one of those rollers moved on the bed at the time I am talking about. The movable roll was out of order, and was so until 1873; it was bolted to the bed like the other roller, and was not adjustable, because some of the parts which made it adjustable were broken off. The knives scraped the sounds off the rollers."

Caleb J. Norwood, Dep pp. 37, 38 [*Tr. Rec.* pp. 25, 26, 27].

It thus appears that the complainant, Caleb J. Norwood, agrees with Oliver C. Smith, the machinist who made the machine, that the supports of the scraper for one of the rolls were attached to the journal boxes of that roll; although the former states it to be the stationary roll, while the latter says it was the movable roll. This difference, as we shall show further on, is not important in face of the entire agreement that one of the rolls was originally made adjustable, and that both rolls were provided with stationary scrapers.

It does not appear how long before 1873 the parts by which the movable roll was adjusted had become broken; but that is immaterial, because the fact remains that the machine was perfect at the outset, and that it was, in all essential respects, substantially the same as represented by the model Exhibit A which was put in evidence to illustrate the machine described in the patent in suit.

The fact that both of these mumming rolls had scrapers applied to them during their use by C. Norwood & Son from 1867 to 1873 is nowhere denied, and is positively attested by three of the workmen.

Stephen Norwood, Int. 28. p, 73 [*Tr. Rec.* p. 50].
James H. Stevens, Ints. 12, 13, p. 135 [*Tr. Rec.* p. 92].
Esrom Morse, Ints. 12–15, p. 140 [*Tr. Rec.* p. 96].

One of these workmen, however, testifies that, to the best of his recollection, both the scrapers and the boxes for the rolls were stationary.

To be sure he says that during his employment there for two seasons he worked on the mumming rolls only about a week more or less, and there does not appear to be any reason why he should have become acquainted with such details of construction as pertain

merely to means for adjustment; but his remembrance about the boxes of the rolls may be fully explained by the testimony of Caleb J. Norwood that while the machine was used by C. Norwood & Son the parts which made one of the rolls adjustable were broken off so that it had to be used in a fixed position.

Stephen Norwood, Ints. 28, 31, pp. 73, 74 [*Tr. Rec.* pp. 50, 51].
Caleb J. Norwood, Int. 35, pp. 37, 38 [*Tr. Rec.* p. 26].

Of course the scrapers were "stationary" in the sense of the term as used in the claim of the patent in suit; but if the witness intended to imply that they were incapable of adjustment, then he was manifestly in error; because the edges of such scrapers next to the surfaces of the rolls must necessarily wear away, and it has always been common practice to provide them with slots and set screws at their ends for the purposes of adjustment.

Oliver C. Smith, Cross-Int. 91, p. 160 [*Tr. Rec.* p. 110].
James M. Parker, Int. 4, p. 164 [*Tr. Rec.* p. 112].
John C. Gilbert, Int. 2, pp. 165, 166 [*Tr. Rec.* p. 113].
John J. French, Ints. 10, 11, p. 168 [*Tr. Rec.* p. 115].

Moreover, the patent granted to Ebenezer Rowe, December 19, 1848, gives specific directions for making adjustable the hollow water-cooled rolls of the isinglass machine therein described as follows: —

"The journals so made are to run and be supported in boxes which are provided with adjusting screws or other suitable contrivances, by which one of the rollers may be moved towards or away from the other as circumstances may require."

Ebenezer Rowe's patent of 1848, p. 282 [*Tr. Rec.* p. 193].

And in view of the undisputed evidence that one of the rolls of the mumming machine built for Norwood & Manning in 1860 was adjustable, it follows conclusively that the scraper for that roll must of necessity have been provided with means for making its position conform to the adjustments of the roll itself.

As to the two sets of rolls, each provided with scrapers, which were made for use by J. J. Manning & Brother at their father's factory in Rockport in 1868, and which were so used thenceforward until

1873 and thereafter, the complainant, John J. Manning, testifies that the scraper for the adjustable roll of each set was attached to the bed of the machine until 1871, and that then the attachment was changed to the boxes of such roll.

John J. Manning, Cross-Ints. 49–69, pp. 27–29 [*Tr. Rec.* pp. 19, 20].

On the other hand, the machinist, Oliver C. Smith, who made these rolls and scrapers, testifies that the machinery was similar to what he had made for the Ipswich factory, and James B. Rowe, one of the defendants, who worked for J. J. Manning & Brother in 1868, testifies that he thinks both scrapers were attached to the boxes of the rolls.

Oliver C. Smith, Int. 29, p. 153 [*Tr. Rec.* p. 105]; Int. 38, p. 154 [*Tr. Rec.* p. 106].

James B. Rowe, Int. 30, pp. 51, 52 [*Tr. Rec.* pp. 35, 36].

See also:

Eben Rowe, Int. 18, p. 100 [*Tr. Rec.* p. 68].

But this question whether the scraper of the movable roll was attached to the bed of the machine or to the journal boxes of the roll itself, — which the testimony of Caleb J. Norwood, one of the complainants, has raised in respect to the machine used in the Ipswich factory from 1860 to 1873, and which the testimony of John J. Manning, the other complainant, has raised in respect to the machines used in the Rockport factory from 1868 to 1871, — does not affect the question of the adjustability of the scraper at all, but simply concerns the capability of changing the adjustment of the roll without disturbing the relative position of its scraper. If the scraper were attached to the bed of the machine it would have to be readjusted whenever its roll was moved; but if it were attached to the journal boxes of its roll it would partake of the same movement, and thus maintain the relative position which it had before.

There is really no evidence that the scrapers were not adjustable, and positive evidence that they were. We have seen that Oliver C. Smith, the machinist who built the machine for the Ipswich factory in 1860, testifies in respect to it that "the scraper itself could be altered as it wore away," and that "the scraper had a slot in each

end through which a bolt screwed into the arm," by which it was supported; and the complainant, John J. Manning, explicitly admits that in the machines at the Rockport factory, as originally constructed in 1868, the scraper, even though attached to the bed, was adjustable and was held by set-screws.

Oliver C. Smith, Cross-Ints. 90, 91, p. 16) [*Tr. Rec.* p. 110].
John J. Manning, Cross-Int. 63, p. 28 [*Tr. Rec.* p. 20].

The facts, then, upon which the complainants and appellants must base their contention that the use of the invention in controversy was experimental, stand thus, by preponderating and for the most part uncontroverted evidence, viz. : —

First. The mumming machine constructed for Norwood & Manning in 1860, and used thenceforward for thirteen years in the Ipswich factory, always had two scrapers attached thereto, one for each roll.

Second. This machine, as originally built, contained means for adjusting one of the rolls towards and from the other.

Third. The scrapers were provided with slots and set-scews at their ends, and were by this means adjustable.

Fourth. The same is true of the mumming machines, and their rolls and scrapers constructed for James Manning in 1868, and thenceforward used by his sons, J. J. Manning & Brother, in the Rockport factory for five years before the patent in suit was applied for.

Further than this, there is some evidence that during the later years of the use of the mumming rollers in the Ipswich factory by C. Norwood & Son, the parts by which the movable roll was adjusted became broken, so that it had to be used in one fixed position.

And it is a disputed point whether or not the scraper for the movable roll of the Ipswich machine, or of either of the Rockport machines, before 1871, was attached to the journal boxes of such

roll, so as to partake of its change of position and not require separate adjustment.

But even if these two contested matters be conceded to the complainants, they are irrelevant to the issue here raised.

It is to be noted that in the patent sued upon the adjustability of the rolls, although an old and customary feature in isinglass machines, is not even insisted on as requisite, but is only mentioned as preferable; and it is to be further noted that although in the specification of this patent the supports of the scrapers are described as attached to the journal boxes of the rollers, yet this feature is not even hinted at in the claim, but the scrapers are simply designated therein as being "stationary."

Indeed, the patent does not even specify the adjustability of the scrapers as essential, but simply says that "each is preferably made adjustable by screws *k* and slots *l*."

Complainants' Patent, pp. 42, 43 [*Tr. Rec.* pp. 28, 29, 30].

Moreover, the patented invention is not a machine, but is explictly stated in the claim to be a *method*, and the question for determination under the issue here considered is whether the practice of such method in connection with the mumming rolls of the Ipswich factory from 1860 to 1871, and with the mumming rolls of the Rockport factory from 1868 to 1871, was in fact a continued experiment *by the inventor himself* for the purpose of perfecting his invention, as contradistinguished from an ordinary use in the way of business.

Certainly the method employed for converting isinglass into sheets did not undergo the slightest change or alteration during the entire thirteen years prior to the application for the patent in suit. All the machinery which was required to practise it consisted simply of the old hollow water-cooled rollers, described in Ebenezer Rowe's 1848 patent, and "stationary scrapers" applied thereto; and the evidence is overwhelming that the mumming machine used at the Ipswich factory, from 1860 to 1873, as well as those used at the Rockport factory, from 1868 to 1873, embraced all these.

Not only so, but it does not even appear that James Manning himself, the alleged inventor, ever personally had anything to do with the application of scrapers to the rolls, either at the Ipswich factory or at the Rockport factory, much less that he ever paid any attention to their working at any time.

In both cases they were applied by the machinist who was employed to make the rolls, and his testimony — that he did the work without instruction from James Manning as to the mode in which the scrapers were to be applied, and without any claim on the part of James Manning that they appertained to any invention of his — shows that the idea of ever attempting to secure the same by a patent was an afterthought, which did not arise until the defendant corporation began business in the fall of 1872.

Oliver C. Smith, Ints. 16–27, pp. 152, 153 [*Tr. Rec.* pp. 104, 105]; Ints. 35–38, p. 154 [*Tr. Rec.* pp. 105, 106].

It would seem to have been incumbent upon the complainants, if they really believed there were any valid reasons for this suggestion of experimental use, to introduce evidence tending to show that James Manning was engaged in good faith in testing the invention in controversy for the purpose of perfecting the same during the entire period of eleven years of its use, prior to the statutory limit of two years before his application for the patent in suit; but there is not a word of testimony that the method of converting isinglass into sheets practised by the use of the mumming rolls with stationary scrapers at the Ipswich factory by Norwood & Manning, from 1860 to 1867, and by C. Norwood & Son, from 1867 to 1871, and at the Rockport factory by J. J. Manning & Brother from 1868 to 1871, was not in every way as practical, efficient, satisfactory, and complete as at any time between 1871 and 1873, within the two years' public use allowed by statute.

Nor did the complainants call upon James Manning, the alleged inventor, to testify at all; although he was alive and in vigorous health for a man of seventy-two years, at the time the evidence in this case was introduced.

John J. Manning, Ints. 85, 86, p. 31 [*Tr. Rec.* p. 22].

Under the circumstances, then, the prior use of the invention in controversy, beyond the two years' statutory limit, conclusively appears to have been a public use; and the complainants have not sustained the burden of proof which rests upon them to show that it was in any respect experimental, within the meaning of the law.

III. The method practised by Norwood & Manning and C. Norwood & Son in the Ipswich factory, and by J. J. Manning & Brother in the Rockport factory, between 1860 *and* 1871, *was the very thing claimed in the patent sued upon.*

The claim of the patent sued upon is in the following language:—

"The herein described method of converting isinglass into sheets of any desired thickness by running it between hollow rolls into which cold water is thrown to cool the compressing surfaces, such rolls being preferably made adjustable to graduate the degree of compression, and the adhering sheets being removed from the rolls by stationary scrapers or clearers, and returned to the hopper as required."

Complainants' Patent, p. 43 [*Tr. Rec.* pp. 29, 30].

Now it is abundantly proved and entirely uncontroverted that the whole of this method, and all the machinery by means of which it is practised, were old long before 1860, except only in so far as the same concerns the use of stationary scrapers automatically applied to the rolls of this particular machine.

Indeed, the method and mechanical means for practising it, minus such stationary scrapers, were fully described in the patent to Ebenezer Rowe, December 19, 1848.

Transcript Record, pp. 192, 193.

The addition, therefore, of stationary scrapers to the rolls of such a machine, which took place when Oliver C. Smith made the machinery for the Ipswich factory of Norwood & Manning in 1860, and the use thereof from that date onward, completed and reduced to practice the invention here in controversy (*ut supra*, pp. 33, 34).

The allegation of the complainant, John J. Manning, that only one scraper was originally applied to these rolls, stands alone and is refuted by the testimony of the machinist who made the machine, and of the workmen who were employed at the time in the room where it was used (*ut supra*, pp. 32, 33).

Nor would it, if true, affect the issue here under consideration, since it is admitted by both complainants, as well as attested by all the workmen who have testified on the subject, that there were scrapers upon both rolls of the machine at the dissolution of the firm of Norwood & Manning in 1867, and so continued to be thenceforward during the use by C. Norwood & Son (*ut supra*, pp. 34, 35).

The suggestion of the complainant, Caleb J. Norwood, that during the later years of the use of this machine by C. Norwood & Son the parts by which one of the rolls was made adjustable were broken off, so that it had to be used in a fixed position, cannot affect the question of the method practised therewith; because the adjustments of the roll are effected before the machine is put into operation; and while the method is being practised the roll is, to all intents and purposes, fixed in position. Besides, as has already been remarked, the patent in suit and the claim therein explicitly declare that the rolls are "preferably made adjustable," and in nowise indicate that adjusting devices are essential.

Finally, the question whether prior to 1871 the supports of the scraper for the movable roll of either of the mumming machines used at the Ipswich or Rockport factories were attached to the bed of the machine, or to the journal boxes of the roll, is still more inconsequential for the purposes of the issue here under consideration.

The method which is claimed in the patent sued upon could not be practised as therein specified, with "stationary scrapers," until after all the adjustments required for making them stationary had been made; and therefore the means by which they are supported or adjusted cannot affect the method, which only requires them to be fixed in position.

But even if the adjustability of the scrapers were specified as requisite and not merely, as the patent states, a matter of preference; the evidence conclusively shows that the scrapers upon the mumming rolls, both at the Ipswich factory and at the Rockport factory, prior to 1871, were provided at their ends with slots and set-screws to make them adjustable, just as described in the patent sued upon (*ut supra*, pp. 37, 38).

The learned judge who decided this case was therefore in error when he stated that "there was contradictory testimony as to whether the scrapers were made adjustable until within two years before the application."

Opinion of the Court, *Transcript Record*, p. 215.

The contradictory testimony so referred to was not whether or not each scraper was provided with slots and set-screws at its ends to enable it to be adjusted towards and from the surface of the roller; but was whether the supports of the scraper for the movable roll were attached to the bed of the machine or to the journal boxes of the roll (*ut supra*, p. 37).

If, as the complainants testified, the scraper for the movable roll was attached to the bed of the machine, then whenever the adjustment of the roll was altered, there would have to be made a separate corresponding readjustment of the scraper; but if, as the machinist who built the machines testified, and as one of the defendants also testified, the scraper for the movable roll was attached to the journal boxes of such roll, then the position of the scraper relatively to the surface of the roll would not be changed by the readjustment of the latter, but the two would together partake of the same movement (*ut supra*, pp. 34, 35, 37).

This is manifest from the following testimony of John J. Manning, one of the complainants: —

Cross-Int. 63. *Was the scraper*, which was attached to the bed of the machine, *capable of adjustment* to and from the surface of the roll?

Ans. *It could be*, by removing it from its position entire, and then the

position of the roll be changed as the operator might choose to, and then the scraper be placed in its former position and held there *by set-screws.*

John J. Manning, Dep. p. 28 [*Tr. Rec.* p. 19].

The counter-testimony of the machinist who built the machines is as follows: —

Cross-Int. 91. Please give me the exact construction of this scraper and the arms, — how the scraper was fastened to the arms, and how and to what the arms were secured.

Ans. *The scraper had a slot in each end, through which a bolt screwed into the arm.* The arms were bolted on to the movable boxes on the front end, and the back arms were bolted either to the boxes or the bed-piece.

Oliver C. Smith, Dep. p. 160 [*Tr. Rec. p.* 109].

The evidence, therefore, in respect to the question whether the scrapers were made adjustable more than two years before the application, fully justified the court below in the opinion that such was the fact, and showed that it was not even such a matter of controversy as the learned judge had supposed. His conclusions on the subject are expressed as follows: —

"I think it probable that they were so made; but whether so or not, the adjustability of the rollers or the scrapers is not of the essence of the invention, as described and claimed by the patentee, or in fact."

Opinion of the Court below, *Transcript Record*, p. 215.

Much less also is the essence of the invention, as described and claimed in the patent sued upon, or in fact, concerned with the mode of attachment of the supports for the scrapers. The contradictory testimony as to whether such supports were attached to the bed of the machine or to the boxes of the rolls, is as remote from the subject matter of the invention under consideration as would be a controversy whether the machine was operated by a water wheel or by a steam engine.

The method or mode of operation of converting isinglass into sheets by passing it between hollow water-cooled rolls, and clearing it from the surface of the same by stationary scrapers, as described in the specification and set forth in the claim of the patent in suit,

is practised perfectly, efficiently, and completely, irrespective of the mechanical means by which the parts of the machine are mounted and applied.

While the rolls are in operation their position must be fixed and the same is true of stationary scrapers. Hence it results that no change in the mechanical means by which such rolls and scrapers are given the fixed position which they must maintain while the patented method is being practised, can be regarded as an improvement upon the method itself, but only at best an improvement upon the machine which is not the patented invention here in controversy.

The conclusion is inevitable, therefore, that the mumming machine built for Norwood & Manning and used by them and their successors, C. Norwood & Son, in the Ipswich factory, from 1860 to 1871, and the mumming machines built for James Manning, and used by J. J. Manning & Brother in the Rockport factory from 1868 to 1871, were fully adapted for the practice of the method claimed in the patent in suit; and that in the actual use made of those machines, the invention here in controversy was completely and perfectly practised.

See

Am. Hide, etc. Co. v. *Am. Tool, etc. Co.* 1 Holmes, 503, 513.
Henry v. *Francestown Soapstone Co.* 2 Fed. Rep. 78, 80.
Hall v. *McNeale*, 23 Off. Gaz. 937, 939. (Sup. Ct. U. S.)

APPELLANTS' ATTEMPTED REPLY TO THE DEFENCE OF WANT OF NOVELTY.

Before taking up what the complainants in the court below had to say about the evidence of anticipation of the patented invention here in controversy, it will be well to describe, more particularly than has yet been done herein, the manufacture of isinglass, to which the same relates.

The swimming bladders of certain fishes are largely composed of that variety of gelatine called isinglass, and are known in the mar-

ket as "sounds." The hake, on the New England coast, furnishes a considerable source of supply of this material, and the sounds are usually found in the market in a dry and hard state.

This manufacture of isinglass is a purely mechanical operation, and consists simply in kneading the sounds together into a somewhat homogeneous mass, and then rolling it out into thin ribbons.

The state of the art as it formerly existed is well set forth in the patent No. 5,978, granted to Ebenezer Rowe, December 19, 1848, in the following language: —

"After the air bladder of the fish has been suitably prepared for manufacture into isinglass, or ichthyocolla, by breaking or reducing it in a machine or mill, consisting of a roller and knives, by which the air bladder is cut up or reduced into small pieces, it is next to be run or caused to pass between iron or composition rollers, so as to convert it into long and very thin sheets or strips. After this process has been completed the said sheets are dried for use.

"Great care is required to prevent the material from becoming so soft while passing between the flattening rollers as to stick or adhere to them, the softening taking place in consequence of the heat generated during the operation."

Ebenezer Rowe's Patent of 1848, p. 282 [*Tr. Rec.* p. 192].

This patent goes on to describe the previous mode of cooling the rollers by applying ice to their surfaces; and then follows a description of the patentee's improved method of cooling the rollers by making them hollow, and causing cold water to circulate through them.

Ebenezer Rowe's Patent of 1848, pp. 282, 283 [*Tr. Rec.* pp. 192, 193].

Such hollow water-cooled rolls, as we have already seen from the evidence adduced, have been constantly used for the same purpose ever since; and the older method, mentioned in Ebenezer Rowe's patent, of first cutting up the sounds into small pieces, seems to have been discontinued.

The mode of procedure has been to first soak the sounds until they become plastic, and then to put them directly through what are

called the mumming rolls, by which the mass is flattened into a sheet of irregular form, similar to dough when rolled out for pie-crust.

John J. Manning, Cross-Int. 72, pp. 29, 30 [*Tr. Rec.* p. 21].
Stephen Norwood, Cross-Int. 83, p. 81 [*Tr. Rec.* p. 55].

Exhibit B is a sample of the sounds to be treated and Exhibit C a sample of the sheet formed by the operation of the mumming rolls.

John J. Manning, Int. 5, pp. 20, 21 [*Tr. Rec.* pp. 14, 15].
Caleb J. Norwood, Int. 13, p. 35 [*Tr. Rec.* p. 24].

These pie-crust-like sheets are next put through what are called preparing rolls or coarse ribbon rolls, where they are still further flattened and elongated into strips or coarse ribbons, which are then in turn put through what are called finishing rolls or fine-ribbon rolls, whereby they become still thinner and longer.

The thin ribbons so produced are finally hung up in a drying room, and when dry are ready for the market as ribbon isinglass.

John J. Manning, Int 3, p. 20 [*Tr. Rec.* p. 14].
Caleb J. Norwood, Int. 6, p. 34 [*Tr. Rec.* pp. 23, 24].
James B. Rowe, Int. 7, p. 46 [*Tr. Rec.* p. 32].

Ever since about the time of Ebenezer Rowe's patent of 1848, the rolls of each of these sets have always been hollow and provided with means for cooling them by the introduction and circulation of cold water within them; and such cooling has been the agency relied upon to keep the isinglass from adhering to the surfaces of the rolls.

James B. Rowe, Ints. 17, 18, pp. 48, 49 [*Tr. Rec.* p. 33].

Indeed, the importance of maintaining low temperature is evidenced by the fact that this manufacture has been carried on only during the winter season and that the most favorable weather for it is when the thermometer is down to zero and the wind northwest.

John J. Manning, Ints. 16, 17, p. 22 [*Tr. Rec.* p. 16].
Stephen Norwood, Cross-Ints. 47, 48, p. 76 [*Tr. Rec.* p. 52].

And the fact that, during such times as it was practicable to carry on the manufacture at all, these water-cooled rolls were efficient in preventing the isinglass from sticking to them, is shown by the evidence that the product obtained by their operation was in the form of sheets or ribbons; whereas if the material had been sticky and adherent, it could not have been removed from the surface of the rolls in any such definite shape.

John J. Manning, Int. 5, pp. 20, 21 [*Tr. Rec.* pp. 14, 15].

So true is this, that the finishing rolls or fine ribbon rolls through which the isinglass is run several times to bring it to the required thinness have never had scrapers applied to them or used in connection with them; and not until of late years have such scrapers been put upon the coarse ribbon rolls.

John J. Manning, Int. 4, p. 20 [*Tr. Rec.* p. 14]; Cross-Int. 56, p. 28 [*Tr. Rec.* p. 19].

Caleb J. Norwood, Int. 6, p. 34 [*Tr. Rec.* pp. 23, 24]; Ints. 11, 12, p. 35 [*Tr. Rec.* p. 24].

In the operation of the mumming rolls, however, while the crude mass of sounds is being kneaded together, and before it takes shape as a sheet like rolled pie-crust, there is likely to be more or less adhesion to the surface of the rolls; and in that case it has to be peeled off with a scraper and put through again until it ceases to adhere and comes out in a flat slab suitable to be passed to the coarse ribbon rolls.

John J. Manning, Int. 3, p. 20 [*Tr. Rec.* p. 14].

James B. Rowe, Int. 7, p. 46 [*Tr. Rec.* p. 32].

William Wingood, Jr., Int. 10, p. 115 [*Tr. Rec.* p. 78]; Ints. 33, 34, p. 117 [*Tr. Rec.* p. 80].

Up to the year 1860, when stationary scrapers were put on to the mumming rolls built for Manning & Norwood, it had been the custom to strip off the adhering material with a scraper fixed in the end of a wooden handle and called a "spudger." This implement was used whenever the workman deemed proper, and, of course, had to be applied in case the material did not free itself from the cold

surfaces of the rolls and come away therefrom as a non-adherent sheet or slab.

John J. Manning, Ints. 8–11, pp. 21, 22 [*Tr. Rec.* p. 15].
James B. Rowe, Ints. 8, 9, p. 47 [*Tr. Rec.* p. 32].
Stephen Norwood, Int. 11, p. 71 [*Tr. Rec.* p. 49].
Eben Rowe, Int. 5, p. 97 [*Tr. Rec.* p. 67].
William Robbins, Int. 5, pp. 108, 109 [*Tr. Rec.* p. 74].
William Wingood, Jr., Ints. 31, 32, p. 117 [*Tr. Rec.* p. 80].

The special form of scraper mounted in a frame, as represented by the model, defendants' Exhibit No. 1, and used at Gott & Giles's, Rockport factory for one season between 1858 and 1860, was also applied to the rolls at the will of the workman, to strip off the material when it became adherent, in order to give it a chance to clear itself at a subsequent passage and to come out in suitable shape for presentation to the action of the next set of rolls.

James B. Rowe, Ints. 3, 4, p. 45 [*Tr. Rec.* p. 31]; Cross-Ints. 50–53, pp. 55, 5 [*Tr. Rec.* p 38]; Cross-Ints. 55–60, pp. 56, 57 [*Tr. Rec.* p. 39]; Cross-Ints. 65–67, p. 57 [*Tr. Rec.* pp. 39, 40].
Stephen Norwood, Ints. 12–14, p. 71 [*Tr. Rec.* p. 49]; Ints. 17–19, p. 72 [*Tr. Rec.* p. 49]; Int. 186, p. 92 [*Tr. Rec.* p. 63]; Cross-Ints. 215–218, p. 96 [*Tr. Rec.* p. 66].
Eben Rowe, Int. 3, p. 97 [*Tr. Rec.* p. 67]; Ints. 6–10, p. 98 [*Tr. Rec.* p. 67]; Cross-Ints. 31–35, p. 102 [*Tr. Rec.* p. 70]; Cross-Ints. 42–44, p. 103 [*Tr. Rec.* p. 71].
William Robbins, Ints. 6–10, p. 109 [*Tr. Rec.* pp. 74, 75]; Cross-Ints. 20–43, pp. 111, 113 [*Tr. Rec.* pp. 76, 77].

If, therefore, the question related to the mechanical means employed for doing this work, the application of stationary scrapers to the machine might be considered an improvement over the use of hand scrapers, because it would be a labor-saving contrivance; but so far as concerns the method of converting isinglass into sheets by passing it between hollow water-cooled rolls and clearing it from the surfaces of the rolls when it adheres thereto, the act of peeling the material off is no different when performed automatically from what it is when done by manual labor.

It may be said that the action of the stationary scrapers affixed to the machine itself is invariable and constant, while that of the man-

ually applied scrapers is uncertain and inconstant, because depending upon the volition of the workman; but it cannot be denied that the latter has it in his power to perform the operation just as constantly and efficiently as the automatic scrapers, even if the rolls should have to be stopped for that purpose.

The question is not as to the relative convenience and economy of the mechanical means employed, but solely as to the act which enters into the series of operations constituting the method claimed.

Suppose, for instance, that the workman tending a pair of mumming rolls, not provided with stationary scrapers, to be so careless or inattentive as to permit the partially masticated sounds to adhere to the surface of the roll long enough to be carried around on it for several successive revolutions; and then suppose that he bestirred himself to clear the adherent material from the surface of the roll with a hand scraper, such as the spudger. The mass so stripped off would have to be returned by him to the action of the rolls, in order to give it the proper form of a sheet suitable for the operation of the coarse ribbon rolls; and this being done, how would the *method* of treatment differ in any respect from that described and claimed in the patent sued upon?

The isinglass would thus, in the language of the claim, be converted into a sheet of the desired thickness by running it between hollow rolls into which cold water is thrown to cool the compressing surfaces; and the adhering sheet would be removed from the rolls by a clearer or scraper, and returned to the hopper as required.

Can it be said, therefore, that even at the hands of an inattentive or lazy workman the patented method was not practised, because the application of the scraper may have been voluntary and occasional instead of automatic and constant.

Manifestly the difference is merely in the degree of thoroughness with which the patented method is carried out and not in the kind of acts which go to make up the method practised.

But this supposition of inattention and neglect on the part of the workman is made simply for the purposes of comparison under the most unfavorable circumstances for the defence of anticipation.

The evidence, on the contrary, abundantly shows that in the use of the hollow water-cooled rolls at the old Rockport factory, carried on by Gott & Giles for many years prior to 1860, there was never any difficulty in keeping the rolls cleared of the crushed fish sounds by means of the implements used for that purpose, to wit, the so-called spudger and the frame scraper like Exhibit No. 1; and that whenever the gelatinous mass adhered to the surface of the rolls it could readily be stripped therefrom without stopping their rotation.

James B. Rowe, Int. 4, p. 45 [*Tr. Rec.* p. 31]; Ints. 8, 9, p. 47 [*Tr. Rec.* p. 32]; Ints. 22-24, pp. 49, 50 [*Tr. Rec.* p. 34]; Int. 31, p. 52 [*Tr. Rec.* p. 36]; Cross-Ints. 117-121, pp. 63, 64 [*Tr. Rec.* pp. 43, 44]; Int. 142, p. 66 [*Tr. Rec.* p. 45].

Stephen Norwood, Ints. 16-22, p. 72 [*Tr. Rec.* pp. 49, 50].

Eben Rowe, Ints. 7-11, p. 98 [*Tr. Rec.* p. 67]; Cross-Ints. 48-50, p. 104 [*Tr. Rec.* p. 71].

William Robbins, Cross-Ints. 27-45, pp. 111-113 [*Tr. Rec.* pp. 76, 77].

The complainants have, however, set up a theory that the product of the manufacture when manually applied scrapers are used for clearing the rolls is different, both in quantity and quality, from that produced when stationary scrapers are employed; but they have adduced little or no evidence tending to support such a proposition.

John J. Manning, one of the complainants, assumes to testify as to the relatively smaller quantity of isinglass produced with the spudger than with the scraper attached to the rolls.

John J. Manning, Ints. 13, 14, p. 22 [*Tr. Rec.* pp. 15, 16].

But the absurdity of such testimony is manifest from his admission that his entire acquaintance with the manufacture of isinglass by means of hollow water-cooled rollers has been confined to that carried on by Norwood & Manning at Ipswich since 1860, and by himself and brother at Rockport since 1868, wherein the rolls have always been provided with stationary scrapers; and for all that appears he never used a spudger in his life.

John J. Manning, Cross-Int. 26, p. 24 [*Tr. Rec.* p. 17].

On the other hand the evidence shows that at the old Rockport factory, carried on by Gott & Giles prior to 1860, the amount of isinglass made was from four hundred to five hundred pounds per day; while at the factories of Norwood & Manning, J. J. Manning & Brother, and even that of the defendant company, the amount varied from two hundred and fifty to five hundred and forty pounds.

Caleb J. Norwood, Cross-Int. 44, p. 39 [*Tr. Rec.* p. 27].
James B Rowe, Int 10, p. 47 [*Tr. Rec.* p. 32]; Int 13, p. 48 [*Tr. Rec.* p 33]; Cross-Ints. 82-88, pp 59, 60 [*Tr. Rec.* p 41].
Stephen Norwood, Ints. 23, 24, pp. 72, 73 [*Tr. Rec.* p. 50].
Eben Rowe, Ints. 28-30, pp. 101, 102 [*Tr Rec.* pp. 69, 70].
Benjamin Tarr, 2d, Int. 16, p. 132 [*Tr. Rec.* p. 90].
Esrom Morse, Ints. 16, 17, p. 140 [*Tr. Rec.* p. 96].

Nor is the testimony as to a greater rate of manufacture in the factory of Caleb J. Norwood since 1873 in conflict with the foregoing; because it appears that a larger number of rolls have been employed, and that a new water wheel of increased power has been put in, besides the fact that the factory has been run nights.

Caleb J. Norwood, Ints. 49-51, p. 39 [*Tr. Rec.* pp. 27, 28]; Cross-Ints. 52-58, p. 40 [*Tr. Rec.* p. 28].
Esrom Morse, Ints. 24-26, p. 141 [*Tr. Rec.* pp. 96, 97]; Cross-Ints. 49-57, pp. 144, 145 [*Tr Rec.* p. 99]; Ints. 60, 61, pp. 145, 146 [*Tr. Rec.* p. 100]; Cross-Ints. 71-73, p. 147 [*Tr. Rec.* 100, 101].

Of course this question of quantity manufactured is one depending upon many different factors, and no scientific demonstration has been attempted; but sufficient evidence has been adduced to show that the complainants have furnished no proof in support of the bare assertion made by one of them, without personal experience, that the use of the hand-applied scraper diminished the quantity of manufacture as compared with that produced when the scrapers were affixed to the machine; and on the other hand it is manifest from such testimony as can be had on the subject that the weight of evidence is against such an assumption.

As to the matter of the influence upon the quality of the product of the respective modes of clearing the rolls from adherent material by manual and by automatic means, the evidence is conclusively against

the suggestion of the complainants, that any substantial difference exists between them.

Even John J. Manning, when asked whether, when making isinglass by rolls and with the aid of the spudger, the product was as uniform and good as with the rolls and scrapers, answered only, "We never could make it so uniform."

John J. Manning, Int. 12, p. 22 [*Tr. Rec.* p. 15].

He did not say that it was not so good; and why he should have presumed to testify at all on the subject is hardly consistent with honesty, in view of his express admission that his acquaintance with the isinglass business began in Norwood & Manning's factory and continued in the factory carried on by himself and brother, where the rolls always had stationary scrapers, and where there is no evidence of the spudger ever having been used.

John J. Manning, Int. 21, p. 23 [*Tr. Rec.* pp. 16, 17]; Cross-Int. 26, p. 24 [*Tr. Rec.* 17].

To this feeble and inconsequential testimony the complainants have added only that of a chemical expert who reports upon certain special experiments made at the factory of the complainant, Caleb J. Norwood, during the progress of this suit.

This chemist testifies that he witnessed the manufacture of a small quantity of isinglass both with and without the application of stationary scrapers to the rolls; but he had no personal knowledge of the kind of sounds from which it was made, nor how they were prepared for the manufacture.

James F. Babcock, Cross-Ints. 9, 10, p. 297 [*Tr. Rec.* p. 203]; Cross-Ints. 13, 14, p. 298 [*Tr. Rec.* p. 203]; Cross-Ints. 20, 21, p. 300 [*Tr. Rec.* p. 205].

He then tested small portions of each of these samples of isinglass so made, to determine the amount of gelatine in each that was soluble in cold water; and he states as the result of his experiments that there was about five per cent more such gelatine in the isinglass

made without the use of stationary scrapers than in the isinglass made when the stationary scrapers were attached.

James F. Babcock, Int. 4, p. 296 [*Tr. Rec.* p. 202]; Cross-Ints 24–28, pp. 301, 302 [*Tr. Rec.* pp. 205, 206].

Now the inconclusiveness of such an experiment will appear at once, when it is considered that the quantity of isinglass upon which each of these tests was made was *only one hundred grains;* and that the selection had to be made from a product into which entered very many sounds of great variety of condition, notwithstanding any care exercised in their selection.

Such sounds are dried before they are delivered to the isinglass manufacturer; and there is a variety known as sunburnt sounds, which this chemist says he has found to contain twice as much gelatine soluble in cold water as he did in the sample of isinglass made without the aid of stationary scrapers.

James F. Babcock, Int. 4, p. 296 [*Tr. Rec.* p. 202].

And if excessive exposure to the sun in the process of drying affects the isinglass of the sounds in this manner, who can say that even a moderate exposure does not produce the same effect in a proportionately less degree in sounds which are not recognized in the market as sunburnt?

Surely, then, no man can tell that the differences, which this chemist found in testing such small quantities as one hundred grains taken from the much larger masses of isinglass operated upon, may not have resulted solely from differences in the original condition of the sounds themselves, which constituted the portions selected for the experiment.

Moreover, the distinction between isinglass which contains about three per cent of gelatine soluble in cold water and that which contains perhaps eight per cent will be seen to be merely fanciful and speculative and to have no practical bearing, when it is considered, as this chemist states, that the difference for the purposes of clarify-

ing beer would be only the almost infinitesimal one of *one tenth of a grain to the gallon!*

James F. Babcock, Cross-Ints. 60, 61, p. 311 [*Tr. Rec.* p. 212].

And, furthermore, he admits that, whether soluble or insoluble in cold water, the gelatine acts in one way or another to clarify the beer for which such isinglass is used.

James F. Babcock, Cross-Ints. 43–45, p. 306 [*Tr. Rec.* p. 209]; Cross-Ints. 58, 59, pp. 310, 311 [*Tr. Rec.* p. 212].

Finally, what is of still more importance, he admits that if the fish sounds are not allowed to heat in the process of manufacturing isinglass therefrom, the quality of the latter will not be deteriorated; which, of course, reduces the whole question to one of care and attention on the part of the workmen. His testimony on this point is as follows:—

"If heat could be wholly avoided in all the steps leading to the production of isinglass, I think the particular form of machinery would make but little difference, if any, in the character of the product. Mechanism then, of course, could simply affect the facility of production or the merchantable appearance of the isinglass. Its qualities as a clarifier, I think, would be the same."

James F. Babcock, Ans. to Cross-Int. 62, p. 311 [*Tr. Rec.* p. 212].

The complainants' attempted reply to the defence of anticipation of the patented method is, therefore, that a chemist upon analysis of one hundred grains of isinglass which has been made without the use of stationary scrapers, from sounds of which he personally knew nothing, has found five per cent more of gelatine soluble in cold water than in a like quantity of isinglass made when stationary scrapers were used; and that this difference, which may have resulted, for all that he knows, from variations in the condition of the sounds themselves before they were operated upon, represents in practice when utilized for clarifying beer, the very ridiculous matter of one tenth of a grain to the gallon. Even if this amounted to a scientific demonstration it has not been shown to have any practical significance, and as a legal proposition the maxim *de minimis non curat lex* applies.

On the other hand, the testimony of competent witnesses abundantly shows that at the old Rockport factory, carried on by Gott & Giles, when the scrapers were applied by hand no practical injury resulted to the isinglass.

James B. Rowe, Cross-Ints. 137, 138, p. 66 [*Tr. Rec.* p. 45]; Ints. 143, 144, p. 66, 67 [*Tr. Rec.* pp. 45, 46].
Stephen Norwood, Cross-Ints. 139–143, p. 87 [*Tr. Rec.* pp. 59, 60].
William Robbins, Ints. 18, 19, p. 110 [*Tr. Rec.* p. 75].
William Wingood, Jr., Ints. 46–51, pp. 118, 119 [*Tr. Rec.* pp. 81, 82]; Cross-Int. 80, p. 123 [*Tr. Rec.* p. 84].
John J. French, Int. 2, p. 167 [*Tr. Rec.* p. 114]; Cross-Int. 45–53, pp. 173, 174 [*Tr. Rec.* pp. 118, 119].

And all agree that there is no difference in the quality of the product, whether made with rolls to which stationary scrapers are attached or with those where hand scrapers only are used.

James B. Rowe, Int. 19, p. 49 [*Tr. Rec.* p. 34]; 2d dep., Ints. 10–13, p. 197 [*Tr. Rec.* p. 134]; Cross-Ints. 14–61, pp. 197–203 [*Tr. Rec.* pp. 134–139].
Stephen Norwood, Int. 15, p. 71 [*Tr. Rec.* p. 49].
William Wingood, Jr., Ints. 46, 47, pp. 118, 119 [*Tr. Rec.* p. 81].
Edward P. Lowe, Int. 5, p. 210 [*Tr. Rec.* p. 143]; Cross-Ints. 131–135, pp. 222, 223 [*Tr. Rec.* pp. 151, 152].
George H. Bush, Ints. 3–9, pp. 230, 231 [*Tr. Rec.* pp. 157, 158].
John J. French, Ints. 2–5, p. 167 [*Tr. Rec.* p. 114].
S. Dana Hayes, Ints. 13, 14 pp. 267, 268 [*Tr. Rec.* pp. 182, 183]; Cross-Ints. 36–56, pp. 273–276 [*Tr. Rec.* pp. 186–188].

In this connection we would refer to the following testimony of the chemical expert called on behalf of the defendants in respect to the method of manufacture described in the patent to Ebenezer Rowe of Dec. 19, 1848, and in the complainants' patent sued upon, as well as that practised by the defendant company. He says: —

"The process or method pursued in this manufacture consists, in my judgment, of a mechanical mode of treating fish sounds to produce commercial ribbon isinglass. It is a series of acts performed upon the sounds, which are thus transformed into a different state. It requires that the sounds should be repeatedly passed between the different sets of rollers in the order given; but the machinery, tools etc., do not in any wise affect the result, although they add to the convenience of the operatives. With this understanding of the process or method of manufacture, I am unable

to find any material difference between the method pursued by Rowe, Manning and the Cape Ann Company either with or without the use of the stationary scraper or the hands alone and the hand scraper or spudger for removing the crushed sounds from one or two of the sets of rollers.

I am confirmed in this belief by the practical trials which were made under my observation at the Cape Ann Isinglass and Glue Company's factory during my visit there. We then made isinglass when the scraper was attached to the roller, and again afterwards, using the same kind of crude stock, we made isinglass without any stationary scraper, and the products are precisely the same. I have analyzed and tested the isinglass made in both ways at that time, and find that one is no better and no more valuable than the other, and they are neither of them materially different from ribbon isinglass previously sold and used about Boston.

The method or process of manufacture being thus the same, and the product being also the same, I do not regard the scraper for removing the material from the machinery at one stage of its passage through, in preference to the hands or hand scraper, as being anything more than a convenience for the operatives. It constitutes no part of the method or process of manufacture, in my judgment, as it is entirely unnecessary to the successful manufacture of isinglass, although it may save some manual labor."

S. Dana Hayes, Ans. 8, pp. 264, 265 [*Tr. Rec.* pp. 180, 181].
See also Ints. 13, 14, pp. 267, 268 [*Tr. Rec.* pp. 182, 183].

In conclusion, we have to say that the question whether isinglass which, when it becomes adherent to the rolls, is stripped therefrom by a scraper attached to the frame of the machine, is or is not better than isinglass which, when it sticks to the rolls, is peeled off with a scraper applied by the hands of the workman at his discretion, is immaterial to the issues in this case; for such a question simply concerns the relative convenience of the mechanical devices employed.

The series of acts performed upon the isinglass is substantially the same in the two instances, and, therefore, the process or method practised is the same. The use of one instrumentality may be more economical and reliable than the use of the other, but that relates to the improvement of the machinery and its mode of operation, — not to the process which the material treated undergoes; because it is manifest that the continuity of the action of the hand scraper is simply a matter of manual labor.

And we confidently insist, therefore, that there is nothing in the nature of a patentable novelty attaching to the method described and claimed in the complainants' patent sued upon, in view of the prior state of the art.

Suggestion of appellants that the claim of the patent in suit is for a mechanical combination.

In the court below the complainants suggested that the claim of the patent in suit might be so construed as to embrace in its subject matter not strictly a method or mode of treatment, but rather a combination of the mechanical parts which constitute the machine described.

Such an interpretation, however, would do violence to the plain and obvious meaning of the language employed.

The specification of the patent explicitly declares: —

"The invention consists in this method of passing the isinglass between hollow rolls cooled by water thrown into the rolls and then stripping the gelatinous matter from the rollers and returning it to the hopper to be again treated, the rollers being adjustable."

Transcript Record, p. 29.

And the claim itself is no less explicit, to wit: —

"The herein-described method of converting isinglass into sheets of any desired thickness by running it between hollow rolls into which cold water is thrown to cool the compressing surfaces, such rolls being preferably made adjustable to graduate the degree of compression, and the adhering sheets being removed from the rolls by stationary scrapers or clearers and returned to the hopper as required."

Transcript Record, p. 30.

Now, to disregard the patentee's express statements that his invention consists of a method of treating isinglass, and to interpret the claim as though its subject matter was the mechanism specified, would

be contrary to the spirit in which the patent law has hitherto been administered.

Merrill v. *Yeomans*, 94 U. S. 568, 571, 573.
Burns v. *Meyer*, 100 U. S. 671, 672.
Water Meter Co. v. Desper, 101 U. S. 332, 337.

Moreover, as we have already shown, the machine of the patent sued upon, apart from the scrapers attached thereto, is as old as the patent granted to Ebenezer Rowe, Dec 19, 1848, wherein it was fully described; and considering the fact that stationary scrapers had been applied to machines with hollow rolls long prior to James Manning's alleged invention, for the very purpose of removing adherent material from the surfaces of such rolls, it is difficult to see how there could be any patentable invention in applying the same kind of scrapers to the rolls of an isinglass machine. [*Ut supra*, pp. 7, 8.]

Respectfully submitted,

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